

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

U.S. Trademark Registration No.: 2,554,110
Trademark: EXP

TTAB

U.S. Trademark Registration No.: 2,554,111
Trademark: EXP COATED

GIBSON GUITAR CORP.)
309 Plus Park Blvd.)
Nashville, Tennessee 37217)
)
Petitioner,)
)
v.)
)
J. D'ADDARIO & CO., INC.)
595 Smith Street)
Farmingdale, New York 11735)
)
Registrant.)
)
)
)

Cancellation Nos: 92041175
and 92041688

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REGISTRANT'S BRIEF IN OPPOSITION TO THE PETITION FOR CANCELLATION

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STATEMENT OF THE ISSUES

Whether Petitioner Gibson Guitar Corp. ("Petitioner") has sufficiently used the marks EXP and EXP COATED so as to create an association in the minds of the purchasing public between the marks EXP and EXP COATED and the Petitioner's goods.

Registrant D'Addario's Answer: No.

Whether Petitioner has carried its burden of proving that it has priority of use of the marks EXP and EXP COATED over Registrant's use of its registered trademarks EXP and EXP COATED.

Registrant D'Addario's Answer: No.

Whether Petitioner has carried its burden to prove that D'Addario's Registration No. 2,554,110 for EXP creates a likelihood of confusion with Petitioner's claimed designation "exp" and should be cancelled.

Registrant D'Addario's Answer: No.

Whether Petitioner has carried its burden to prove that D'Addario's Registration No. 2,554,111 for EXP COATED creates a likelihood of confusion with Petitioner's claimed designation "exp" and should be cancelled.

Registrant D'Addario's Answer: No.

SUMMARY OF THE ARGUMENT

INTRODUCTION

This is a situation that turns on the facts, not the law. With respect to the issue of priority of use, Registrant will show that Petitioner has failed to meet its burden of proving that Petitioner used the marks

EXP and EXP COATED first. Petitioner admits that it has never used the mark EXP COATED.

Petitioner further admits that it has never advertised or promoted the mark EXP, submits no evidence of any monetary expenditures for advertising the mark EXP, has never used it on its products (except for an assertion of use on a warranty card after Registrant's priority date), and never used the marks in any of its catalogs. Petitioner alleges it uses not the mark EXP, but rather the letters "exp" as part of a longer alphanumeric code, unrecognizable as a trademark, in its dealer price lists and dealer invoices. The alphanumeric codes, e.g. EXP2KOGH1, employing the letters "exp", are just three of about 300 codes used in the dealer invoices and dealer prices lists, with no emphasis on the "exp" portion, no trademark notification, such as "TM", and no indication whatsoever to the dealer that the "exp" portion of the code is considered a trademark of Petitioner. How can someone tell from the code "EXP2KOGH1" whether the "ex" portion is the trademark, or the "exp" portion, or the "exp2k" portion, or the "exp2ko" portion, or the "kog" portion, or the "gh1" portion, or whether the entire alphanumeric code, is a trademark and associates that portion of the code with Petitioner?

Petitioner submits no evidence that consumers or anyone recognizes the "exp" portion of the code to be a trademark proprietary only to Petitioner, or that consumers or anyone associates the "exp" portion of the code with Petitioner and its goods.

Registrant's use of the marks EXP and EXP COATED, on the other hand, is extensive. In just the year 2003, Registrant has sold more than \$1,000,000 in sets of musical instrument strings with the marks EXP and EXP COATED prominently displayed on the packaging. In the year 2003, Registrant has spent more than \$330,000 in advertisements and promotion of its EXP and EXP COATED marks. Registrant sells its EXP and EXP COATED strings in over 106 countries. It has produced numerous unsolicited customer letters praising the quality and longevity of its EXP and EXP COATED strings and showing the public's recognition of these registered marks as being associated with Registrant and Registrant's products.

In summary, it is Registrant, not Petitioner, who has priority of using the marks EXP and EXP COATED, and Petitioner has failed in its burden of proof in this regard.

Both the Petitioner and the Registrant, J. D'Addario & Co., Inc., agree that the factors enumerated in *In re du Pont de Nemours & Co.*, 177 USPQ 563 (CCPA 1973), control in determining the likelihood of confusion to the public by Petitioner's and Registrant's use of the marks EXP and EXP COATED. However, Registrant respectfully urges that the *DuPont* factors, applied to the facts herein, weigh in favor of Registrant.

Notwithstanding the fact that Petitioner is the latecomer in its alleged use of the mark EXP, and admits that it has never used the mark EXP COATED, Petitioner concentrates its use of the letters "exp", as part of a longer alphanumeric code, e.g. EXP2EBGH1, with its dealerships only, and not to the consuming public. Only the dealers would see the code on Petitioner's dealer price lists and dealer invoices, among a myriad of alphanumeric codes, not the end user or consuming public of Petitioner's product. Petitioner does not advertise or promote the EXP mark. It is never found in any of Petitioner's product catalogs. Accordingly, Petitioner's use, if any, of "exp" as part of its codes is limited solely to its dealers. It has been this way since 1993, according to Petitioner, with no indication that such use of "exp" will ever change.

Registrant, on the other hand, has extensively promoted and advertised its marks EXP and EXP COATED at the consumer or end-user level. It has sold over \$1 million in sets of strings in the year 2003 alone, with the marks EXP and EXP COATED prominently displayed on the packaging for the strings. Petitioner's use of "exp" in its dealer invoices and dealer price lists do not reach the consuming public.

Furthermore, Registrant has spent more than \$330,000 in the year 2003 alone, advertising and promoting its EXP and EXP COATED marks. Petitioner has spent nothing (\$0) on advertising and promoting its alphanumeric codes on its dealer invoices and dealer price lists which incorporate the letters "exp". Not one product catalog bears the EXP and EXP COATED mark. Thus, there exist different

market levels where Registrant's use of the marks EXP and EXP COATED and Petitioner's use of its alphanumeric codes are found.

The consuming public clearly recognizes the EXP and EXP COATED marks as trademarks belonging to Registrant, and associates these trademarks with Registrant's products. The record includes numerous unsolicited letters from end users of Registrant's strings praising the quality and longevity of the EXP and EXP COATED strings, clearly evidencing the public's recognition and association of the EXP and EXP COATED trademarks with Registrant and Registrant's products. On the other hand, the record is devoid of any evidence showing any recognition or association by end users or dealers of the alphanumeric codes using the letters "exp" as part of the codes on the dealer invoices and dealer price lists as being a trademark of Petitioner and functioning as an indication of the source of Petitioner's products.

Petitioner makes no attempt to enlighten the reader of its dealer price lists and dealer invoices as to what portion of the code it considers its trademark. No "TM" notation or advisory language is found on the dealer price lists and dealer invoices. No reader would be able to tell what the trademark is. Not even in the few instances where "exp1", "exp" and "exp2" are used on the dealer price lists, buried amongst a myriad of other codes, would generate any recognition by the reader that the "exp" portion of the code is a trademark of Petitioner and functions thusly. "Exp" has never been used alone on Petitioner's dealer price lists and dealer invoices, nor in its advertisements and product catalogs. Petitioner submits no documentary evidence, such as customer or dealer letters, showing recognition or an understanding by anyone that "exp" in its dealer price lists and dealer invoices functions as and is a trademark of Petitioner. Eleven years of such use of "exp" (according to Petitioner) and not one letter showing recognition that the marks EXP and EXP COATED are trademarks of Petitioner was produced. Petitioner submitted no survey evidence showing either recognition of the "exp"-part code as a trademark. No survey evidence showing confusion between Registrant's use of the marks EXP and EXP COATED

and Petitioner's use of "exp" as part of its codes on its dealer invoices and dealer price lists was submitted by Petitioner.

Even after more than three years of concurrent use of Registrant's EXP and EXP COATED marks and Petitioner's use of "exp" in its alphanumeric codes on its dealer price lists and dealer invoices, there is not one instance of actual confusion caused by each party's use.

Despite what Petitioner alleges, it has not policed the marketplace for third party users of the mark EXP. It took Registrant, after only a simple search on the Internet, to make Petitioner aware of other guitar distributors and guitar accessory sellers who are currently using the mark EXP on their products. Third party users include Peavey Electronics Corporation for its EXP line of guitars (Ex. C); Legend Guitar Company for its EXP series of guitars (Ex. D); Ed Roman Guitars for its line of EXP guitars (Ex. E); The ESP Guitar Company for its line of EXP guitars (Ex. F); Roland Corporation which sells an EXP guitar expression pedal (Ex. G); Godlyke Distributing Inc. (Bixonic) for its EXP-2001 guitar effects processor (Ex. H); and Kimex Trading Ltd for its EXP/EX3 guitar equalizer (Ex. I).

Even in the presence of third party use of the mark EXP, Petitioner has found not one instance of actual confusion with its use of "exp" as part of its alphanumeric code on its dealer price lists and dealer invoices.

Accordingly, it is highly unlikely that confusion to the public will result from Registrant's continued use of the marks EXP and EXP COATED on its products and Petitioner's use of the letters "exp" forming part of its alphanumeric code used in its dealer invoices and dealer price lists, and Petitioner failed in its burden of proof in this regard. Petitioner also never submitted that it plans to expand its use of "exp" from its alphanumeric codes used on its dealer price lists and dealer invoices to use on or in connection with its guitars. If it does, such new use will be subject to the earlier rights of third party users of the mark EXP, and the prior rights of Registrant.

Registrant respectfully asks the Board to consider the overall situation which brought the two parties to this forum. Petitioner filed its applications long after Registrant's applications and well after Registrant began extensive marketing of its EXP and EXP COATED products. Petitioner filed intent-to-use applications, not actual use application, because it did not have an actual use of the EXP mark. When Petitioner received office actions rejecting its applications based on Registrant's earlier registrations for the EXP and EXP COATED marks, it invented an ethereal "first use" claim based solely on an unrecognizable and unassociatable use of the letters "exp" in a longer alphanumeric code used only in its dealer price lists and dealer invoices in an effort to cancel Registrant's registrations and suspend the prosecution of its own.

Petitioner never really used the marks EXP and EXP COATED. No advertising, no promotion, not a penny spent. The marks are not in its product catalogs, and are not displayed on its products. Petitioner may have had a policy of policing the trade dress of its guitars and its other marks, but it never policed "exp", because it never considered "exp" to be its trademark. Petitioner may have had a legitimate interest in attempting to preserve the right to "exp" and "ex" by filing its intent-to-use applications, but they are second in priority to Registrant's registrations and its extensive use of the EXP and EXP COATED marks worldwide on its products.

Accordingly, Registrant respectfully requests the Board to deny the pending petitions to cancel its registrations.

SUMMARY

1. On December 8, 2000, Registrant J. D'Addario & Co., Inc., filed intent-to-use trademark applications for the trademarks EXP and EXP COATED. These later issued as the registrations in this proceeding. Ex. BV and BW. Registrant first used the EXP trademark in commerce at least as early as January 22, 2001. Ex. BV; at D48, D'Addario Tr. 24:7-12. Similarly, the mark EXP COATED was first used in commerce at least as early as January 22, 2001. Ex. BW; at D17. D'Addario Tr. 26:13-21. The

marks EXP and EXP COATED have been extensively used by Registrant in interstate commerce on the goods identified in the registrations, i.e., strings for mandolins, classic guitars and electric guitars.

D'Addario Tr. 27:6-18.

2. Since the EXP and EXP COATED strings were introduced in 2001, the strings have been sold in 106 countries using the aforesaid marks. D'Addario Tr. 28:4-11. In the United States, the EXP and EXP COATED strings have been sold in 5000-6000 stores since the introduction of the strings. D'Addario Tr. 28:15-23. In the year 2003 alone, U.S. sales of the EXP strings exceeded 1.2 million dollars, and over 200,000 sets of strings were sold. Ex. BX; D'Addario Tr. 29:14-30:24.

3. For the year 2003, Registrant spent over \$330,000 advertising and promoting its EXP and EXP COATED products. Ex. BZ; D'Addario Tr. 37:4-38:9. Registrant has extensively promoted its EXP and EXP COATED marks in print advertising and web advertising on the D'Addario website and other portals Registrant participates in. D'Addario Tr. 31:7-18. There is also an extensive artist relations program for the EXP and EXP COATED strings. D'Addario Tr. 31:7-18. Registrant has also advertised the EXP and EXP COATED trademarks in a variety of musical publications since the introduction of the strings in 2001. The trade publications include Music and Sound Retailer, Music Trades, Musical Merchandise Review and Music Inc. Registrant has also advertised the EXP and EXP COATED strings in consumer publications including Guitar Player, Guitar One, Acoustic Guitar, Guitar World and others. D'Addario Tr. 34:20-35:7. The EXP and EXP COATED strings are also advertised and promoted in connection with over 25 trade shows a year. D'Addario Tr. 35:8-20.

4. Registrant D'Addario's strings have achieved an excellent reputation in the industry. D'Addario Tr. 11:18-12:2. Registrant has won awards for the quality of its EXP strings. In 2001 and 2002, Registrant won the "Grammy of Music Products", the MusikMesse International Press Award for the most "Innovative Guitar Strings". Ex. CD at D 077. Registrant receives substantial numbers of unsolicited consumer letters praising the quality of Registrant's strings. D'Addario Tr. 12:3-9.

5. Petitioner claims trademark rights in “exp”. However, it has produced no advertising to the general public for the mark EXP. It has produced no dollar totals for the amounts of advertising and promotion for the term “exp”. Petitioner has produced a plurality of dealer suggested retail price lists to demonstrate its use of “exp”. None of these price lists uses “exp” by itself. In fact, the product is always described as the “Explorer”. There is no use of “exp” by itself. Ex. 1-6, 11,12. Petitioner submits no evidence whatsoever that it has ever used the mark EXP COATED and, in fact, admits that it has not. Berryman Tr. 188:24-189:21.

6. In addition to the dealer price lists, the Petitioner also claims that it has used the term “exp” on dealer invoices. However, as in the case of the dealer price lists, Petitioner has only used the term “exp” along with other letters and numerals. These invoices only go to dealers, and there has been no evidence that any consumer has ever seen such an invoice. Ex. 7, 8 and 10. As in the case of the dealer price lists, these invoices do not show the use of the mark EXP by Petitioner. In each instance, the hundreds of alphanumeric codes used on the dealer invoices includes one of the following: “EXP1EBCT1”, and “EXP2EBGH1” and “EXP2KOGH1”. Not one of these dealer invoices highlights or emphasizes the “exp” portion of the alphanumeric code in any way or draws attention to it. Ex. 0, Berryman Tr. 102:19-104:2, Ex. M, Berryman Tr. 105:23-107:3; Ex. Q.

7. In order to rely on analogous trademark rights to support a claim for priority, the Federal Circuit has held in *Herbko International, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1162 (Fed. Cir. 2002), that the Petitioner must demonstrate that the prior use creates an association in the minds of the purchasing public between the mark and the Petitioner's goods.

8. Petitioner's President, David Berryman, admits that the Petitioner's price lists do not inform the public that EXP is a trademark of Petitioner. Mr. Berryman testified concerning Ex. M, an Epiphone 1998 price list which is similar to all the other price lists relied on by Petitioner as follows:

Q. All right. On this page, underneath the Instrument Code, there is "EXP2", do you see that there?

A. Yes.

Q. Okay. How can someone tell that "EXP2" is considered a trademark of Gibson Guitar?

* * *

The Witness:

"Well, they couldn't, because there's no markings on this page." Berryman Tr. 87:24-89:2.

The record and Petitioner's brief are silent on the existence of any evidence that demonstrates that there is any association of the mark EXP and Petitioner's goods in the minds of the purchasing public. There is no evidence of any advertising or promotion of the mark, and no evidence that Petitioner drew any attention to "exp" being a trademark. Berryman Tr. 148:5-159:4, Ex. AJ-AU, Exhibit 1-6, 11, 12, M, N; Berryman Tr. 80:16-23, Tr. 101:24-102:5, 191:8-12. In all of its advertising, Petitioner has never once used the mark EXP. Ex. AO, AT, AU, AX, AY, BA, BB, BD-BQ; Berryman Tr. 191:8-12.

Petitioner claims that in April, 2001, it started to use the mark EXP on cards shipped with its product, which comes after Registrant's January, 2001 actual use of the marks EXP and EXP COATED

and its 2000 priority date. Berryman Tr. 30:7-12. Even the proof of use submitted by Petitioner does not show any use of the mark EXP by itself. *Jim Dandy Co. v. Martha White Foods, Inc.*, 458 F.2d 1397, 1399, 173 USPQ 673, 674 (CCPA 1972) ("while a party may rely on advertising and promotional use of a term or slogan to show superior rights over a subsequent trademark use of a term, the prior advertising must have been of such nature and extent that the term or slogan has become popularized in the public mind"). (Emphasis added by underlining.) Here, there has been no such advertising by Petitioner to support his claim of analogous use. In addition, none of Petitioner's catalogs uses the mark EXP. Ex. AX-BG, BH-BS, Berryman Tr. 160:17-170:21, 174:16-188:17.

9. As discussed in detail below, an examination of the *DuPont* factors, *In re E.I. duPont de Nemours & Co.*, 177 USPQ 563 (CCPA 1973), demonstrates that the balance of the factors tips toward the Registrant, and as a result, there is no likelihood of confusion.

10. Registrant has extensively used the trademarks EXP and EXP COATED since the date of first use over three years ago in January, 2001. There was over 1 million dollars in sales of EXP and EXP COATED strings in 2003, and over \$330,000 was spent in advertising and promotion of the marks EXP and EXP COATED during that year. Ex. BZ. Nevertheless, neither Petitioner nor Registrant is aware of any instance of actual confusion. D'Addario Tr. 39:2-15, 39:24-40:16; Ex. A (Responses 1 and 18 in Petitioner's Responses to Registrant's First Set of Interrogatories dated April 15, 2003; Item 15 in Registrant's Notice of Reliance dated March 17, 2004).

RECITATION OF THE FACTS

REGISTRANT D'ADDARIO BY AND THROUGH ITS FAMILY HAS BEEN IN THE BUSINESS OF MAKING INSTRUMENT STRINGS SINCE 1680

Registrant J. D'Addario & Co., Inc., by and through its family predecessors, has been in the business of making strings for musical instruments since 1680. D'Addario Tr. 6:18-24. The present company was founded in 1974 and has over 700 employees and operations in California, Illinois and New York. D'Addario Tr. 7:6-13. Its EXP and EXP COATED strings are sold in 106 countries, including the United States. D'Addario Tr. 7:7-13. Petitioner's President admitted that D'Addario holds "the largest market share in the string replacement market". Berryman Tr. 10:11-16.

The core business of Registrant is strings for guitars and other fretted instruments, as well as strings for the bowed instrument family, including the violin, viola, cello and bass. D'Addario Tr. 10:17-20. In addition, D'Addario manufactures drum heads for drums. D'Addario Tr. 10:20-22. Other products include guitar straps, saxophone straps, instrument cables, microphone and audio cables, tools for musicians to assist in changing strings, peg winders and other accessories for musical instruments. D'Addario Tr. 10:23-11:7. Registrant does not manufacture guitars or other musical instruments. D'Addario Tr. 11:8-12.

THE EXP AND EXP COATED REGISTRATIONS IN SUIT

On December 8, 2000, Registrant filed an intent-to-use trademark application for the trademark EXP. Ex. BV. On the same date, Registrant filed an intent-to-use trademark application for the mark EXP COATED. Ex. BW. Both applications subsequently issued as registrations on March 26, 2002. The mark EXP is registered under Registration No. 2,554,110 for the following goods: strings for

musical instruments. The mark EXP COATED is registered under Registration No. 2,554,111 for the following goods: strings for musical instruments. Ex. BV and BW.

IN THE MOST RECENT YEAR, 2003, REGISTRANT HAS SOLD OVER 200,000 SETS OF STRINGS DISPLAYING THE MARKS EXP AND EXP COATED

Registrant first used the EXP trademark in commerce at least as early as January 22, 2001.

D'Addario Tr. 24:13-18. Similarly, the mark EXP COATED was first used in commerce at least as early as January 22, 2001. D'Addario Tr. 26:13-21. The marks EXP and EXP COATED have been used by Registrant on strings for mandolins, classic guitars and electric guitars. D'Addario Tr. at 27:6-18. The trademarks EXP and EXP COATED are prominently displayed on the packages carrying the strings. Ex. CD; D'Addario Tr. 27:19-24. Since the EXP and EXP COATED strings were introduced in 2001, the strings have been sold in 106 countries, including the United States. D'Addario Tr. 28:4-11. In the United States, the EXP and EXP COATED strings have been sold in 5000 to 6000 stores since the introduction of the strings. D'Addario Tr. 28:15-23. In the year 2003 alone, U.S. sales of the EXP strings exceeded 1.2 million dollars, and over 200,000 sets of strings were sold. Ex. BX; D'Addario Tr. 29:14-30:24.

REGISTRANT EXTENSIVELY ADVERTISES AND PROMOTES THE MARKS EXP AND EXP COATED IN CONNECTION WITH ITS STRINGS

J. D'Addario & Company, Inc., the Registrant herein, has advertised and promoted its EXP and EXP COATED strings since their introduction into the U.S. and foreign marketplaces in January of 2001. Registrant has done print advertising and web advertising on the D'Addario website and on other portals Registrant participates in. D'Addario Tr. 31:7-18. There is also an extensive artist relations program promoting the EXP and EXP COATED strings. D'Addario Tr. 31:7-18. Registrant has also extensively advertised the EXP and EXP COATED trademarks in a variety of music publications since the introduction of the strings in 2001. Examples of trade publications in which Registrant's marks EXP and

EXP COATED are advertised include Music and Sound Retailer, Music Trades, Musical Merchandise Review and Music Inc. Registrant has also extensively advertised the EXP and EXP COATED strings in consumer publications, including Guitar Player, Guitar One, Acoustic Guitar, Guitar World, and others. D'Addario Tr. 34:20-35:7.

The EXP and EXP COATED strings are also advertised and promoted in connection with trade shows. Registrant promotes its EXP and EXP COATED strings in about 25 trade shows a year. D'Addario Tr. 35:12-20. The trade shows include the two NAMM (National Association of Music Merchants) shows each year, one in California, and the other in Nashville, blue grass shows such as IBMA (International Bluegrass Music Association) in Louisville, Kentucky, Telluride in Colorado and Folk Alliance in California and guitar trading shows. D'Addario Tr. 35:21-37:1. For the year 2003, Registrant spent over \$330,000 advertising and promoting its EXP and EXP COATED marks. Ex. B2; D'Addario Tr. 37:4-38:9. Other advertising and promotion of the EXP and EXP COATED trademarks include retail displays and sponsoring concerts. D'Addario Tr. 38:10-25.

In addition to the advertising and promotional activities discussed above, Registrant has a marketing program with original equipment manufacturers (OEMs) of musical instruments. Under this cooperative program, if the manufacturer buys Registrant's EXP strings, D'Addario uses the OEMs in its consumer and trade marketing programs. D'Addario Tr. 55:6-15; Ex. CL. Further, in the OEM program, the guitar companies specifically tell consumers that their guitars are pre-strung with Registrant's EXP strings. D'Addario Tr. 86:3-10.

REGISTRANT'S EXP TRADEMARK HAS ACHIEVED SIGNIFICANT RECOGNITION IN THE INDUSTRY SINCE FILING ITS INTENT-TO-USE TRADEMARK APPLICATION IN 2000

Registrant D'Addario's strings have achieved an excellent reputation in the industry. D'Addario Tr. 11:18-12:2. Registrant's strings have won awards for the quality of their EXP strings. In 2001 and

2002, Registrant won the “Grammy of Music Products”, i.e., the MIPA (Musikmesse International Press Award) for the most “Innovative Guitar Strings”. Ex. CD at D077. Registrant receives substantial numbers of unsolicited consumer letters praising the quality of Registrant’s strings. D’Addario Tr. 12:3-13:7. See also Ex. BU. A representative letter from a consumer, Mr. Gary Bonura, attesting to the high quality of the product and recognition of Registrant as the owner of the mark EXP, states, in pertinent part:

“First let me say that I have used your EXP strings exclusively since they were introduced. For my money they are the best strings I’ve ever used.”

Ex. BU.

Registrant J. D’Addario is well known in the industry. In fact, it is the largest manufacturer of strings in the world. D’Addario Tr. 17:16-18:6.

The Registrant has over 400 endorsees who endorse Registrant’s EXP and EXP COATED strings. Registrant does not pay for these endorsements but receives the endorsements merely in exchange for free strings. D’Addario Tr. 31:22-32:4. Famous guitarists who endorse Registrant’s EXP and EXP COATED strings include Al Demeola, Dave Matthews, Arlo Guthrie, INXS, Ben Harper, Jackson Browne, Stephen Stills, James Taylor, David Crosby, Janis Ian, Bruce Springstein, Jimmy Buffett, Carlos Santana, K.D. Lang, Lou Reid, Paul Simon, Peter Frampton, Sheryl Crow, Randy Travis, Counting Crows, and The Dixie Chicks. D’Addario Tr. 34:8-19; Ex. BY.

REGISTRANT’S SELECTION OF EXP AND EXP COATED WAS IN GOOD FAITH

Registrant selected the trademarks EXP and EXP COATED in good faith. Registrant was not aware of Petitioner’s alleged use of “ex” or “exp”. D’Addario Tr. 40:17-41:16.

DESPITE THE EXTENSIVE USE BY REGISTRANT OF THE TRADEMARKS EXP AND EXP COATED, THERE HAS BEEN NOT A SINGLE INSTANCE OF ACTUAL CONFUSION

As demonstrated above, Registrant has extensively used the trademarks EXP and EXP COATED since the date of first use over three years ago in January, 2001. There was over 1 million dollars in sales of EXP and EXP COATED strings in 2003, and over \$330,000 was spent in advertising and promotion of the EXP and EXP COATED marks during that year. Nevertheless, neither Petitioner nor Registrant is aware of any instance of actual confusion. D'Addario Tr. 39:2-15, 39:24-40:16; Ex. A (Responses 1 and 18 in Petitioner's Responses to Registrant's First Set of Interrogatories dated April 15, 2003; Item 15 in Registrant's Notice of Reliance dated March 17, 2004).

THE CONSUMERS OF REGISTRANT'S EXP AND EXP COATED STRINGS ARE SOPHISTICATED PURCHASERS

The Registrant's product, although low in relative cost, is sold to sophisticated purchasers. First, the EXP strings cost about double the price of comparable strings when sold at retail. D'Addario Tr. 44:18-24. The typical EXP string customer was described as someone "who has a very high quality instrument costing" upward of \$1,000 to \$3,000. This customer is "someone who knows the difference and wants a good-sounding string, having the convenience of a string lasting longer and that tone a longer period of time". D'Addario Tr. 43:9-21. The EXP and EXP COATED strings are not merely ordinary strings. Rather, the EXP COATED strings have a wrapping wire with a microscopic urethane sealant which prevents the metal from corroding from perspiration or atmospheric conditions. As a result, the strings last 3 to 5 times longer than ordinary strings. D'Addario Tr. 43:22-10. In addition, the wrap wire of the EXP and EXP COATED strings has a hexagonal shape so that, with each turn of the wrap wire, the wrap wire digs into the edges of the core wire, providing a better bond. D'Addario Tr. 44:11-17.

THIRD PARTIES USE "EXP" FOR GUITARS AND MUSICAL ACCESSORIES

The mark EXP is commonly used by others than Petitioner in the sale of guitars and guitar accessories. These include EXP guitars offered by Peavey Electronics Corporation (D'Addario Tr. 62:7-

16; Ex. C; Berryman Tr. 32:20-36:7); EXP guitars sold by Legend Guitar Corporation (Ex. D, Berryman Tr. 41:23-42:17, 45:19-46:2); EXP guitars sold by Ed Roman Guitars (Ex. E; Berryman Tr. 46:5-47:2, 47:22-48:1); and EXP guitars sold by The ESP Guitar Company (Ex. F, Berryman Tr. 54:15-55:14, 56:21-57:7).

Besides guitars, there are many guitar accessories sold in the same types of retail establishments as Petitioner's guitars that use the mark EXP. Third parties selling guitar accessories under the mark EXP at stores that also sell Petitioner's guitars include Roland Corporation, which sells an EXP guitar expression pedal. Ex. G; Berryman Tr. 57:14-61:12; Berryman Tr. 61:13-63:16. Other accessories that are similarly sold for use with guitars and use the designation EXP include the Bixonic Expandora EXP-2001. Ex. H, Berryman Tr. 63:25-65:5. Equalizers used by guitarists to modify the sound emitted by guitars are also sold under the mark EXP/EX3 by Kimex Trading Ltd. Ex. I, Berryman Tr. 67:19-69:8.

Petitioner claims that after being recently informed of these users of the mark EXP on guitars by Registrant, it has written to at least some of them. However, none of these letters was ever produced, and Petitioner's sole witness, the President of the company, never saw such letters. Berryman Tr. 8:16-25, 12:3-24, 12:25-14:22, 27:10-28:12. It is further clear that Petitioner has never warned any musical accessory manufacturer of its alleged rights in "ex" and "exp". Registrant is, like several companies mentioned above, a musical accessory manufacturer, not a manufacturer of guitars. D'Addario Tr. 11:8-17.

PETITIONER HAS NOT USED "EXP" PRIOR TO REGISTRANT

Petitioner alleges that it is using the mark EXP. However, the record does not support such an allegation, as there has been no use of the marks EXP and EXP COATED by the Petitioner. Petitioner sells a guitar called the "Explorer". Since the guitar was introduced, virtually all of Petitioner's references to the guitar have been using word "Explorer". Petitioner claims trademark rights in the mark EXP. However, it has produced no advertising that shows use of the mark EXP, nor has it provided any

documents or testimony to show any monetary amount spent on promoting its alleged mark. In fact, of all the catalogs and advertisements produced by Petitioner for its guitars and other products, none shows any use of the mark EXP. Berryman Tr. 191:8-12; Ex. AO, AT, AU, AX, AY, BA, BB, BD-BQ. Mr. Berryman, President of Petitioner Gibson Corp., admitted during his testimony that no product catalog shows any use of the mark EXP or EXP COATED. Ex. AO; Berryman Tr. 152:16-153:6. Ex. AT; Berryman Tr. 156:18-157:21. Ex. AU; Berryman Tr. 157:23-159:4. Ex. AX; Berryman Tr. 160:16-161:15. Ex. AY; Berryman Tr. 161:23-163:2. Ex. BA; Berryman Tr. 164:5-165:1. Ex. BB; Berryman Tr. 165:3-16. Ex. BD; Berryman Tr. 166:22-167:16. Ex. BE; Berryman Tr. 168:10-169:9. Ex. BF; Berryman Tr. 169:11-170:3. Ex. BG; Berryman Tr. 170:5-171:21. Ex. BH; Berryman Tr. 174:17-176:10. Ex. BI; Berryman Tr. 176:15-177:5. Ex. BJ; Berryman Tr. 177:7-178:8. Ex. BK; Berryman Tr. 178:10-23. Ex. BL; Berryman Tr. 178:25-180:7. Ex. BM; Berryman Tr. 180:9-181:23. Ex. BN; Berryman Tr. 181:25-182:24. Ex. BO; Berryman Tr. 183:1-184:8. Ex. BP; Berryman Tr. 184:10-186:6. Ex. BQ; Berryman Tr. 186:8-187:13.

Petitioner has produced a plurality of dealer suggested retail price lists to demonstrate its use of the mark EXP. However, none of these dealer price lists uses the mark EXP by itself. In fact, the product is always described as the "Explorer". There is no use of "exp" by itself, as the term is proceeded or followed by a letter or number, and is one of hundreds of codes, each indistinguishable from another, appearing on the dealer price lists. Exhibit AG, a representative dealer price list, includes the following codes, and more: EC25, EC40, EOC7, EA20, EA35, EA3T, EA05, EAOL, ER35, EA3C, EAQ1, EA72, EO7S, EO7T, EO7C, EA80, EAJ2, EAJT, EO1E, EO2E, EE35, EE3T, EER3, EE3C, EO7E, EO77, EE80, EEP5, EPP6, EEP7, EFD1, EF30, EF50, EFB1, EFB2, EGS1, EGT1, EGG1, EGG4, EGV1, EGM1, EGM2, EXP1, EES1, ENB, ENS, ENC, ETS2, ETE2, EBAC, EBRO, EBPO, EBM4, EBM5, EIHR, EIEM, EIZE, ENS1, ENR, BASGIG, EPIGIG, E519, ED50, EDREAD, EEMCS, EEXP, EGCS, EH60, EJUMBO, ENLPCS, EPR5, EPR6, ERCS, ESCS, ESUPERIV, EVCS, and EZEPH.

Nowhere in these dealer price lists does Petitioner use the designation "exp" by itself. It is always preceded or followed by other numbers or letters having the same size as "exp" such that Petitioner does not emphasize the designation "exp" apart from the rest of the code. Mr. Berryman testified that there is no "TM" designation or trademark notice on any of Petitioner's price lists to advise the reader that Petitioner considers "exp", "exp1", "exp2" or other codes used therein to be a trademark of Petitioner. Ex. M; Berryman Tr. 75:17-89:9. Ex. N; Berryman Tr. 100:11-102:5. Ex. R; Berryman Tr. 110:1-22. Ex. S; Berryman Tr. 110:24-111:15. Ex. T; Berryman Tr. 111:17-112:10. Ex. W; Berryman Tr. 117:4-118:2. Ex. Y; Berryman Tr. 119:14-120:12. Ex. Z; Berryman Tr. 120:25-126:6. Ex. AA; Berryman Tr. 122:25-126:6. Ex. AB; Berryman Tr. 129:12-131:1. Ex. AC; Berryman Tr. 131:3-132:1. Ex. AF; Berryman Tr. 136:2-24. Ex. AG; Berryman Tr. 137:1-139:1. Ex. AI; Berryman Tr. 147:19-148:2. There is no testimony or documentary evidence that consumers recognize the portion "exp" of one of hundreds of alphanumeric codes to be a trademark of Petitioner.

PETITIONER'S DEALER INVOICES DO NOT USE THE MARK EXP

Petitioner also relies on its invoices to dealers to show its use of the mark EXP. As in the case of the price lists, the notation "exp" is never used by itself but rather is only part of a much longer alphanumeric code, such as "EXP2KOGH1". There is no testimony that any end user of Petitioner's products ever received an invoice with the mark EXP on it. In each of the dealer invoices relied on by the Petitioner, the letters "exp" do not appear by themselves. Rather, they are always combined with other letters and/or numbers. In each invoice produced by Petitioner, the letters "exp" only appear as a small part of an alphanumeric code. Again, there are hundreds of alphanumeric codes that are used on dealer invoices, each alphanumeric code being indistinguishable from another, with no code emphasizing the "exp" portion thereof. Exhibit Q includes a representative number of dealer invoices, which include the following codes: EXP1EBCT1, EXP2EBGH1, EGV2EBGH1, EG05EBCH1, EAJ1EBCH1, EAJ1NACH2, ENC-HSGH1, EXP2K0GH1, ESGSCHCH1, ESGSEBCH1, ESGSOLCH1,

EAA6NAGHI, EEA2EBGH1, EEA2NAGH1, ENSEEBGH1, EFB1MRCH1, EGV2KOGH1, EOC7ANGH1, ENS-HSCH1, and ENSTTAMH1.

Registrant's marks EXP and EXP COATED should be compared with the designation actually used by Petitioner in its dealer price lists and dealer invoices, which always includes additional letters or numerals. There is no testimony that any consumer or dealer of Petitioner's products recognizes the term "exp" as functioning as a trademark and belonging to Petitioner.

PETITIONER'S CONFIDENTIAL DEALER PRICE LISTS DO NOT USE EXP BY ITSELF

Petitioner also relies on confidential dealer price lists to show its use of the mark EXP. In each of these instances, the letters "exp" are always used with other numbers or letters, never alone, and are indistinguishable from the rest of the code in which they are found and from the hundreds of other codes used on the dealer price lists. Exhibit AA, GIB 00081-82, is a representative dealer price list that includes the following codes, and more: EGS1, EGS1L, EGS1, EGT1, EGG1, EGG1L, EGG4, ENB, ENBL, EGV1, EXP1, EGFB, EGM1, EGM2, EEC0, ENHP, ENHS, EEXC, EPR1, EPR2, ESCS, ESTWEE, EGCS, ETTWEE, ENLPCS, EVCS, EEXP, EFBCS, XEGIG, ECOCS, ENHCS, ENLPCS, EPROCS, ELSB, ELPS, ENS, ENSB, ENSL, ENC, ENLPCS, EBEC, EBC4, EBC5, EBAC, EBACL, EBAC, EBRO, EBPOL, EBV1, EBR1, EBEX, EBLP, EBT4, EBT5, EBM4, EBM5, EABCS, ERCS, EVBCS, ERVCS, BASGIG, ETBCS, XBGIG, EENN, EEND, EENR, BAK-PAK, EDIACS, EDORCS, XAGIG, XCGIG, EASK, EESK, E-TSHIRT, E-BLCAP, ED10, EC10, ES20, ES30, EB10, EA22, E800, XEGIG, EC25, EC40, EOC7, EPR6, EA20, EA35, EA3T, EM35, ER35, EA3C, EA05, EA0L, EO7S, EO7T, EO7C, EA80, EAQ1, EAJ2, EAJT, EABM, EAHB, EE20, EE35, EE3T, EME5, EE3C, EO7E, EOTE, EO77, EE80, EAJB, EEJ2, EEP5, EEP5L, EEA5, EEP6, EEP7, ECSS, ECSF, ECBE, ECCE, ECACS, EO1E, EO2E, EF30, EE30, EF50, EE50, EFB1, EFB2, EFD1, ED15, ED50, EH60, ETR1, ETCA, ETSO, ETS2, ETE2, ETE2L, ETEM, E519, EEMCS, and EERCS.

Petitioner submits no testimony or documentary evidence that the dealer price lists are provided to an end user of the product. In fact, the testimony supports the opposite conclusion. Petitioner has included on each dealer price list the legend "CONFIDENTIAL", as Petitioner does not want the end user to see these dealer price lists because they reveal the dealer's cost. Berryman Tr. 123:1-124:12. Petitioner also submits no evidence that any dealer who receives these invoices ever refers to the Explorer guitar by the mark EXP or recognizes the alphanumeric code to be a trademark.

PETITIONER'S WARRANTY CARD DOES NOT SUPPORT PETITIONER'S CLAIM OF PRIORITY

After Registrant filed its applications to register its marks EXP and EXP COATED and began extensive use of its marks in interstate commerce, Petitioner allegedly began to use the mark EXP on its warranty cards. Ex. 14. This exhibit was objected to, as it was never produced during discovery. This exhibit uses "exp" on the cover, and "exp" appears in the section labeled "Inspected by." "Exp" on the warranty card does not refer to a Gibson product, and there is no testimony that the use of "exp" on the warranty card is understood by the public as referring to anything other than the identity of the inspector. There is further no evidence that any consumer or dealer recognizes "exp" as referring to any product of Petitioner. In fact, Petitioner submits no evidence to show that the mark EXP was ever used on, or accompanied, any guitar Petitioner placed in interstate commerce prior to Registrant's application filing dates.

ARGUMENT

REGISTRANT THROUGH ITS EXTENSIVE SALES AND ADVERTISING AND PROMOTION HAS ESTABLISHED VALUABLE RIGHTS AND GOODWILL IN THE MARKS EXP AND EXP COATED THAT SHOULD BE PROTECTED

For the most recent completed year, 2003, Registrant had over \$1,200,000 in sales of its musical instrument strings packaged under the EXP and EXP COATED registered marks. In addition, in 2003 alone, Registrant spent over \$330,000 in advertising and promotion of its EXP and EXP COATED

trademarks. Cancellation of a valuable registration around which a large and valuable business goodwill has been built should be granted only with "due caution and after a most careful study of all the facts." Sleepmaster Products Co., Inc. v. American Auto-Felt Corp., 241 F.2d 738, 113 USPQ 63 (C.C.P.A. 1957).

PETITIONER HAS THE BURDEN OF PROOF IN THIS CANCELLATION PROCEEDING

Registrant's United States Trademark Registration No. 2,554,110 for the mark EXP and Registration No. 2,554,111 for the mark EXP COATED are entitled to a presumption of validity. *West Florida Seafood, Inc. v. Jet Restaurants, Inc.*, 31 F.3d 1122, 31 U.S.P.Q.2d 1660 (Fed. Cir. 1994). As stated in *West Florida Seafood* at 1125:

"A party claiming prior use of a registered mark may petition to cancel the registration on the basis of such prior use pursuant to section 14 of the Lanham Act. 15 U.S.C. Sec. 1064. The burden of proof in a cancellation proceeding for a service mark registration is no different from that for a trademark or certification mark. Thus, a presumption of validity attaches to a service mark registration, and the party seeking cancellation must rebut this presumption by a preponderance of the evidence."

See also *Martahus v. Video Duplication Services, Inc.*, 3 F.3d 417, 421, 27 USPQ2d 1846, 1850 (Fed.Cir.1993) and *Cerveceria Centroamericana, S.A. v. Cerveceria India, Inc.*, 892 F.2d 1021, 1023, 13 USPQ2d 1307, 1309 (Fed.Cir.1989). Petitioner, to sustain its burden of proof, must leave nothing to conjecture. *Prince Dog & Cat Food Co. v. Central Nebraska Co.* F.2d 134 USPQ 366,369, 1309 (C.C.P.A 1962).

PETITIONER HAS FAILED TO MEET ITS BURDEN OF PROOF THAT IT HAS PROPRIETARY RIGHTS IN THE MARKS EXP AND EXP COATED

As discussed in detail above, Petitioner Gibson has made very limited use of the designation "exp". Petitioner relies on price lists that go only to dealers. Ex. 1-6, 11, 12. Neither the record nor Petitioner's brief identifies a single end user that has received a retail price list. In fact, the Petitioner's

brief only states in this regard that “copies of the price lists are also made available to guitar buyer”.

Petitioner’s Brief at 9; Berryman Tr. 14:4-8.

As further discussed in detail above, the price lists do not use the mark EXP. In every instance, the price lists use “exp” preceded or followed with numbers or letters, such as, for example, “EEXP”, “EXP1” or “EXP2”, among hundreds of indistinguishable alphanumeric codes, but never “EXP” alone is used. In each of the dealer price lists cited by Petitioner, no emphasis is placed on the “exp” portion of the codes. Ex. 1-6, 11, 12, AG. These designations are but a few of hundreds of codes that use a variety of alphanumeric combinations on the dealer price list, and no reader of the dealer price list would ever recognize “exp”, as part of a longer code buried in a multiplicity of codes, to be a trademark of Petitioner. Furthermore, Petitioner does not use the designation “TM” when it uses “exp” in any of these codes; it does not highlight or emphasize these designations in any way to draw special attention to them. Exhibits 1-6, 11, 12. See also, Ex. M, N and AG; and Berryman Tr. 80:16-23, and Tr. 101:24-102-5.

In addition to the dealer price lists, the Petitioner also claims that it has used the term “exp” on dealer invoices. However, as in the case of the dealer price lists, Petitioner has only used the “exp” designation along with other letters and numerals preceding or following the term, such as in “EXP1EBCT1”. These invoices only go to dealers, and there has been no evidence that any consumer has ever seen such an invoice. Berryman Tr. 104:24-105:6. As in the case of the dealer price lists, these dealer invoices do not evidence the use of the mark EXP by Petitioner. In each invoice, the designation used by Petitioner is one of many alphanumeric codes, such as the following: EXP1EBCT1, EXP2EBGH1, EGV2EBGH1, EG05EBCH1, EAJ1EBCH1, EAJ1NACH2, ENC-HSGH1, EXP2K0GH1, ESGSCHCH1, ESGSEBCH1, ESGSOLCH1, EAA6NAGH1, EEA2EBGH1, EEA2NAGH1, ENSEEBGH1, EFB1MRCH1, EGV2K0GH1, EOC7ANGH1, ENS-HSCH1, and ENSTTAMH1.

Not one of these dealer invoices emphasizes the term “exp”, apart from the full alphanumeric code as shown on the invoices, in any way, or draws attention to it. No “TM” notation is used by

Petitioner anywhere on the dealer invoice to advise the reader that Petitioner considers the “exp” portion of one of several hundred alphanumeric codes to be its trademark, nor is there any specialized stylizing of the letters or any of the other common ways to emphasize and draw the public’s attention to a trademark. Berryman Tr. 108:3-23, 109:17-25.

The only other “use” of “exp” alleged by Petitioner is on a warranty card that supposedly now is shipped with Petitioner’s product. Ex. 14. Petitioner did not start using “exp” on the warranty card until after Registrant began extensive use of the EXP and EXP COATED trademarks on its strings. More specifically, Petitioner’s alleged date of first use of the term “exp” on its warranty card is April, 2001, which is three months after Registrant’s January 22, 2001 date of first use of its trademarks EXP and EXP COATED and four months after the Registrant filed its trademark application which led to the registrations that are the subject of this proceeding. Berryman Tr. 30:7-9; Ex. WX and WY. Thus, Petitioner has no basis for claiming priority based on its alleged use of “exp” on its warranty card.

In order for Petitioner’s dealer price lists and dealer invoices to have priority over Registrant’s intent-to-use application filing date of December 8, 2000, Petitioner must demonstrate proprietary rights in the mark. *Otto Roth & Co. v. Universal Foods Corp.* 640 F.2d 1317, 1320, 209 USPQ 40, 43 (C.C.P.A. 1981). Prior rights may be demonstrated by prior registration, prior trademarks or service mark use, prior use as a trade name, prior use analogous to trademark or service mark use, or any other use sufficient to establish proprietary rights. *National Cable Television Association v. American Cinema Editors, Inc.*, 937 F.2d 1572, 19 USPQ 2d 1424 (Fed Cir. 1991). Petitioner places great reliance on *National Cable Television*, but the factual circumstances in that case are not present here. In *National Cable Television*, the name of the petitioner had been shortened to ACE by the petitioner’s “officers, by members, by film professionals and in the press”. 937 F.2d at 1574, 19 U.S.P.Q.2d at 1426. No such proof has been offered by Petitioner with respect to its use of “exp” as part of its codes. In addition, the Federal Circuit in *National Cable Television* relied on third party correspondence that used the designation ACE when referring to the petitioner. Petitioner herein has not produced any evidence of any use of, or recognition

by, a third party of the mark EXP to refer to Petitioner's product in the present proceedings. As set forth below, Petitioner has failed to carry its burden of proof to show prior rights in the mark EXP.

PETITIONER HAS FAILED TO DEMONSTRATE AN ASSOCIATION BETWEEN THE MARK EXP AND ITS PRODUCTS IN THE MIND OF THE RELEVANT PUBLIC

Petitioner does not allege that it has prior trademark rights based on its use of the mark EXP. It is only claiming "prior rights in the mark which are 'analogous' to trademark rights". Petitioner's Brief, at 12. In order for a party to rely on analogous trademark rights to support a claim for priority, the Federal Circuit has held in *Herbko International, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1162, 64 U.S.P.Q.2d 1375 (Fed. Cir. 2002), that a petitioner must demonstrate that the prior use creates an association in the minds of the purchasing public between the mark and the petitioner's goods. The C.A.F.C stated in *Herbko*, at 1162 (64 U.S.P.Q.2d at 1378):

"Before a prior use becomes an analogous use sufficient to create proprietary rights, the petitioner must show prior use sufficient to create an association in the minds of the purchasing public between the mark and the petitioner's goods. *Malcolm Nicol & Co. v. Witco Corp.*, 881 F.2d 1063, 1065, 11 USPQ2d 1638, 1639 (Fed. Cir. 1989). A showing of analogous use does not require direct proof of an association in the public mind. *T.A.B. Sys. v. Pactel Teletrac*, 77 F.3d 1372, 1375, 37 USPQ2d 1879, 1882 (Fed. Cir. 1996). Nevertheless, the activities claimed to create such an association must reasonably be expected to have a substantial impact on the purchasing public before a later user acquires proprietary rights in a mark." *Id.*

The record and Petitioner's brief are silent on the existence of any evidence that demonstrates that there is any association of the mark EXP with Petitioner or its products in the minds of the purchasing public. There is no evidence of any advertising or promotion of the mark, and no evidence that Petitioner drew any attention to or emphasized the use of the term "exp". Even the proof of use submitted by Petitioner does not show any use of "exp" by itself.

The Federal Circuit in *Herbko* relied on its earlier decision in *Malcolm Nicol & Co., Inc. v. Witco Corporation*, 881 F.2d 1063, 11 U.S.P.Q.2d 1638 (Fed. Cir. 1989). In *Malcolm Nicol*, the Federal Circuit

discussed the type of evidence that creates the required association in the minds of the consuming public.

The Court stated, at 1065 (11 U.S.P.Q.2d at 1639):

“In an opposition founded on Sec. 2(d), opposer must prove that it has proprietary rights in the term it relies upon to prove likelihood of confusion. The proof could consist of ownership of a registration, prior use of an unregistered mark, prior use in advertising, or as a trade name, or any other type of use which has resulted in establishing a trade identity.... Thus, even prior use by opposer of the term as a trade name ... or use in advertising analogous to trademark use, may be sufficient to preclude registration of that term to a subsequent user. Use "analogous" to trademark use means use of a nature and extent such as to create an association of the term with the user's goods. Examples of use analogous to trademark use to establish priority under Sec. 2(d) include prior use of a term: in advertising brochures, in catalogues and newspapers, and in press releases and trade publications.” (Emphasis added by underlining.)

See also, *Jim Dandy Co. v. Martha White Foods, Inc.*, 458 F.2d 1397, 1399, 173 USPQ 673, 674 (CCPA 1972) ("while a party may rely on advertising and promotional use of a term or slogan to show superior rights over a subsequent trademark use of a term, the prior advertising must have been of such nature and extent that the term or slogan has become popularized in the public mind"). (Emphasis added by underlining.)

There is no evidence in this proceeding of any advertising of the mark EXP by Petitioner, any use of the mark in its catalogues, or in newspapers, press releases or trade publications. Petitioner has failed to disclose any amounts it spent on advertising and promoting the mark EXP. In *Malcolm Nicol*, the evidence that was held not to satisfy the opposer's burden of proof that there was analogous trademark use was described at 1065-1066 (11 U.S.P.Q.2d at 1640):

“The evidence upon which the board based its decision ... consists of 12 articles, each published only once, which appeared in various newspapers and trade journals between December 27, 1963, and April 11, 1964, and a single speech, on April 22, 1964, by one of registrant's vice presidents at a share-holders' meeting. Registrant has pointed to no additional evidence of any significance upon which it may rely.... The articles mentioned above were, in effect, press releases; in all but one, the mark, The Old Swiss House, was buried in the body of the articles. This, in our view, is not the type of public exposure of a mark that would

be expected to have any significant impact on the purchasing public.”
(Emphasis added by underlining.)

The Federal Circuit in *T.A.B. Systems v. Pactel Teletrac*, 77 F.3d 1372, 37 U.S.P.Q.2d 1879 (Fed. Cir. 1996), also held that the evidence presented by the opposer did not sufficiently prove an analogous trademark use. The Federal Circuit initially noted at 1375 (37 U.S.P.Q.2d at 1881) that:

“Such an ‘analogous use’ opposition can succeed, however, only where the analogous use is of such a nature and extent as to create public identification of the target term with the opposer’s product or service.”
(Emphasis added by underlining.)

In addressing the arguments by T.A.B. Systems, that the proffered use did not rise to the required level of recognition for there to be an analogous trademark use, the Federal Circuit stated at 1375 (37 U.S.P.Q.2d at 1882):

“T.A.B. contends that PacTel, much like the opposer in *Old Swiss House*, has failed to adduce evidence legally sufficient to support the critical inference that the consuming public identified the word TELETRAC with a single source as the provider of vehicle tracking and location services prior to October 27, 1989. We agree. We note, first, that PacTel’s use of TELETRAC in various forms prior to June 1989 is simply irrelevant to its analogous use priority rights, inasmuch as neither the vehicle tracking service itself nor PacTel’s connection to it was advertised in any way prior to June 1989. The remaining evidence, while relevant, does not support the necessary inference of public identification.” (Emphasis added by underlining.)

In *T.A.B.*, the evidence consisted of press releases. Of the press releases PacTel issued, only one was shown to have been circulated by a national wire service. The record contained no evidence, however, to indicate how many of PacTel’s potential consumers may have been reached by that wire service story. Although the record indicated that some of PacTel’s press kits were distributed to potential customers, no evidence was presented enabling one to infer that a substantial share of the consuming public had been reached. Petitioner in this proceeding has even less evidence of public awareness of the mark. At least in *T.A.B.*, there were press releases that went to publication. Here, Petitioner is relying on

dealer invoices and dealer price lists without any proof that any end user ever saw the invoices or the price lists or, if they did, the extent to which they saw these documents. In *T.A.B.* the Federal Circuit stated at 1375-76 (37 U.S.P.Q.2d at 1882):

“Finally, the brochures and news articles, all produced in September and October 1989, were not shown to have been so broadly or repetitively distributed that one could reasonably infer that the consuming public came to identify TELETRAC with PacTel's services by October 1989. This record evidence, which does not permit one to infer either that PacTel reached more than a negligible share of potential customers or that the customers who were reached saw more than a few references to TELETRAC over a one or two month period, is legally insufficient to ground PacTel's analogous use claim.”

See also, *Computer Food Stores, Inc. v. Corner Store Franchises, Inc.*, 176 U.S.P.Q. 535 (T.T.A.B. 1973) (analogous use “must be an open and notorious public use directed to the segment of the purchasing public for whom the services are intended, and must be used in a manner sufficient ... to inform or apprise prospective purchasers of the present or future availability of the adopter's service under the mark.”). See also, *Old Swiss House, Inc. v. Anheuser-Busch, Inc.*, 569 F.2d 1130, 196 U.S.P.Q. 808 (C.C.P.A. 1978).

In *T.A.B. Systems v. Pactel Teletrac*, 77 F.3d 1372, 37 U.S.P.Q.2d 1879 (Fed. Cir. 1996), the Federal Circuit held that the opposer must show advertising of sufficient clarity and repetition to create the required identification and that the advertising must have reached a substantial portion of the public that might be expected to purchase the service. See *T.A.B.* at 1378 (37 U.S.P.Q.2d at 1883), where the Federal Circuit stated:

“As noted above, survey evidence has never been required. Nothing we decide today in any way changes that established rule. In fact, however, in many cases lacking survey evidence, advertising programs and budgets are proven to support the inference of public identification. Significantly, no such evidence was produced here. We do not have any evidence that any air time or any newspaper space was purchased. No advertisements were shown to have been placed. We do not even have gross dollar figures on advertising expenditures. Nor do we have any indication of ‘readership.’” (Emphasis added by underlining.)

Similarly, here, Petitioner produced no evidence of advertising expenditures, programs or budgets to support an inference of public identification of the mark EXP or EXP COATED.

THERE IS NO LIKELIHOOD OF CONFUSION UNDER THE C.C.P.A.'S *DUPONT* FACTORS.

The C.C.P.A. in *In re E.I. duPont de Nemours & Co.*, 177 USPQ 563 (CCPA 1973), set forth the factors that should be considered in determining whether there is a likelihood of confusion between two trademarks. An analysis of each of the factors demonstrates that there is no likelihood of confusion in this case. The *DuPont* factors are as follows:

- “1. The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.
2. The similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use.
3. The similarity or dissimilarity of established, likely-to-continue trade channels.
4. The conditions under which and buyers to whom sales are made, i.e. “impulse” vs. careful, sophisticated purchasing.
5. The fame of the prior mark (sales, advertising, length of use).
6. The number and nature of similar marks in use on similar goods.
7. The nature and extent of any actual confusion.
8. The length of time during and conditions under which there has been concurrent use without evidence of actual confusion.
9. The variety of goods on which a mark is or is not used (house mark, “family” mark, product mark).
10. The market interface between applicant and the owner of a prior mark:
 - a) a mere “consent” to register or use.
 - b) agreement provisions designed to preclude confusion, i.e. limitations on continued use of the marks by each party.
 - c) assignment of mark, application, registration and good will of the related business.

d) laches and estoppel attributable to owner of prior mark and indicative of lack of confusion.

11. The extent to which applicant has a right to exclude others from use of its mark on its goods.

12. The extent of potential confusion, i.e. whether de minimis or substantial.

13. Any other established fact probative of the effect of use.”

177 USPQ at 567.

Registrant will address each of these factors *seriatim*:

DuPont Factor 1. The Similarity or Dissimilarity of the Marks in their Entireties As to Appearance, Sound, Connotation and Commercial Impression

Registrant's trademarks are EXP and EXP COATED. As discussed above, Registrant's EXP and EXP COATED trademarks are used on musical instrument strings and have become well known in the business of musical instrument strings in view of Registrant's extensive advertising and promotion, including unpaid endorsements from many famous musicians. Registrant has sold over 1.2 million dollars in strings in the year 2003 alone under the marks EXP and EXP COATED, and has spent over \$330,000.00 annually in advertising and promoting the EXP and EXP COATED trademarks. This should be compared to Petitioner's marketing expenditures, which are \$0 for promoting the marks EX and EXP. No catalogs or advertisements of Petitioner even mention the mark EXP.

Petitioner alleges that it is using the mark EXP. However, there has been no use of mark EXP by the Petitioner, and the actual usage of the letters "exp" relied on by Petitioner is, at best, minimal. Petitioner sells a guitar called the "Explorer". Since the guitar was introduced, virtually all of the references to the guitar have been using the word "Explorer". Petitioner claims trademark rights in the mark EXP. However, it has produced no evidence of advertising to the general public for the mark EXP. It has produced no dollar amounts for advertising and promoting the mark EXP.

Petitioner has produced a plurality of dealer retail price lists to demonstrate its use of the mark EXP. None of these price lists uses "exp" by itself. In fact, the product is always described as the "Explorer". There is no use of "exp" by itself, as the term is preceded or followed by a letter or number, and is one of hundreds of codes, each indistinguishable from another, appearing on the dealer price lists. Exhibit AG, a representative dealer price list, includes the following codes, and more: EC25, EC40, EOC7, EA20, EA35, EA3T, EA05, EAOL, ER35, EA3C, EAQ1, EA72, EO7S, EO7T, EO7C, EA80, EAJ2, EAJT, EO1E, EO2E, EE35, EE3T, EER3, EE3C, EO7E, EO77, EE80, EEP5, EPP6, EEP7, EFD1, EF30, EF50, EFB1, EFB2, EGS1, EGT1, EGG1, EGG4, EGV1, EGM1, EGM2, EXP1, EES1, ENB, ENS, ENC, ETS2, ETE2, EBAC, EBRO, EBPO, EBM4, EBM5, EIHR, EIEM, EIZE, ENS1, ENR, BASGIG, EPIGIG, E519, ED50, EDREAD, EEMCS, EEXP, EGCS, EH60, EJUMBO, ENLPCS, EPR5, EPR6, ERCS, ESCS, ESUPERIV, EVCS, and EZEPH.

Nowhere in these dealer price lists does Petitioner use the designation "exp" by itself. It is always preceded or followed by other numbers or letters having the same size as "exp" such that Petitioner does not emphasize the designation "exp" apart from the rest of the code. Mr. Berryman testified that there is no "TM" designation or trademark notice on any of Petitioner's price lists to advise the reader that Petitioner considers "exp", "exp1", "exp2" or other codes used therein to be a trademark of Petitioner. Ex. M; Berryman Tr. 75:17-89:9. Ex. N; Berryman Tr. 100:11-102:5. Ex. R; Berryman Tr. 110:1-22. Ex. S; Berryman Tr. 110:24-111:15. Ex. T; Berryman Tr. 111:17-112:10. Ex. W; Berryman Tr. 117:4-118:2. Ex. Y; Berryman Tr. 119:14-120:12. Ex. Z; Berryman Tr. 120:25-126:6. Ex. AA; Berryman Tr. 122:25-126:6. Ex. AB; Berryman Tr. 129:12-131:1. Ex. AC; Berryman Tr. 131:3-132:1. Ex. AF; Berryman Tr. 136:2-24. Ex. AG; Berryman Tr. 137:1-139:1. Ex. AI; Berryman Tr. 147:19-148:2. There is no testimony or documentary evidence that consumers recognize the portion "exp" of one of hundreds of alphanumeric codes to be a trademark of Petitioner.

Petitioner also relies on its invoices to dealers to show its use of the mark EXP. As in the case of the price lists, the notation "exp" is never used by itself but rather is only part of a much longer

alphanumeric code, such as "EXP2KOGH1". There is no testimony that any end user of Petitioner's products ever received an invoice with the mark EXP on it. In each of the dealer invoices relied on by the Petitioner, the letters "exp" do not appear by themselves. Rather, they are always combined with other letters and/or numbers. In each invoice produced by Petitioner, the letters "exp" only appear as a small part of an alphanumeric code. Again, there are hundreds of alphanumeric codes that are used on dealer invoices, each alphanumeric code being indistinguishable from another, with no code emphasizing the "exp" portion thereof. Exhibit Q includes a representative number of dealer invoices, which include the following codes: EXP1EBCT1, EXP2EBGH1, EGV2EBGH1, EG05EBCH1, EAJ1EBCH1, EAJ1NACH2, ENC-HSGH1, EXP2K0GH1, ESGSCHCH1, ESGSEBCH1, ESGSOLCH1, EAA6NAGHI, EEA2EBGH1, EEA2NAGH1, ENSEEBGH1, EFB1MRCH1, EGV2KOGH1, EOC7ANGH1, ENS-HSCH1, and ENSTTAMH1.

Registrant's marks EXP and EXP COATED should be compared with the alphanumeric code actually used by Petitioner in its dealer price lists and dealer invoices, which always includes additional letters or numerals. There is no testimony that any consumer or dealer of Petitioner's products recognizes the term "exp" as functioning as a trademark and belonging to Petitioner.

Petitioner also relies on confidential dealer price lists to show its use of the mark EXP. In each of these instances, the letters "exp" are always used with other numbers or letters, never alone, and are indistinguishable from the rest of the code in which they are found and from the hundreds of other codes used on the dealer price lists. Exhibit AA, GIB 00081-82, is a representative dealer price list that includes the following codes, and more: EGS1, EGS1L, EGS1, EGT1, EGG1, EGG1L, EGG4, ENB, ENBL, EGV1, EXP1, EGFB, EGM1, EGM2, EEC0, ENHP, ENHS, EEXC, EPR1, EPR2, ESCS, ESTWEE, EGCS, ETTWEE, ENLPCS, EVCS, EEXP, EFBCS, XEGIG, ECOCS, ENHCS, ENLPCS, EPROCS, ELSB, ELPS, ENS, ENSB, ENSL, ENC, ENLPCS, EBEC, EBC4, EBC5, EBAC, EBACL, EBAC, EBRO, EBPOL, EBV1, EBR1, EBEX, EBLP, EBT4, EBT5, EBM4, EBM5, EABCS, ERCS, EVBCS, ERVCS, BASGIG, ETBCS, XBGIG, EENN, EEND, EENR, BAK-PAK, EDIACS, EDORCS, XAGIG,

XCGIG, EASK, EESK, E-TSHIRT, E-BLCAP, ED10, EC10, ES20, ES30, EB10, EA22, E800, XEGIG, EC25, EC40, EOC7, EPR6, EA20, EA35, EA3T, EM35, ER35, EA3C, EA05, EA0L, EO7S, EO7T, EO7C, EA80, EAQ1, EAJ2, EAJT, EABM, EAHB, EE20, EE35, EE3T, EME5, EE3C, EO7E, EOTE, EO77, EE80, EAJB, EEJ2, EEP5, EEP5L, EEA5, EEP6, EEP7, ECSS, ECSF, ECBE, ECCE, ECACS, EO1E, EO2E, EF30, EE30, EF50, EE50, EFB1, EFB2, EFD1, ED15, ED50, EH60, ETR1, ETCA, ETSO, ETS2, ETE2, ETE2L, ETEM, E519, EEMCS, and EERCS.

Petitioner submits no testimony or documentary evidence that the dealer price lists are provided to an end user of the product. In fact, the testimony supports the opposite conclusion. Petitioner has included on each dealer price list the legend "CONFIDENTIAL", as Petitioner does not want the end user to see these dealer price lists because they reveal the dealer's cost. Berryman Tr. 123:1-124:12. Petitioner also submits no evidence that any dealer who receives these invoices ever refers to the Explorer guitar by the mark EXP or recognizes the alphanumeric code to be a trademark.

After Registrant filed its applications to register its marks EXP and EXP COATED and began extensive use of its marks in interstate commerce, Petitioner allegedly began to use the mark EXP on its warranty cards. Ex. 14. This exhibit was objected to, as it was never produced during discovery. This exhibit uses "exp" on the cover, and "exp" appears in the section labeled "Inspected by." "Exp" on the warranty card does not refer to a Gibson product, and there is no testimony that the use of "exp" on the warranty card is understood by the public as referring to anything other than the identity of the inspector. There is further no evidence that any consumer or dealer recognizes "exp" as referring to any product of Petitioner. In fact, Petitioner submits no evidence that shows that the mark EXP was ever used on, or accompanied, any guitar Petitioner placed in interstate commerce prior to December 8, 2000, the date which Registrant filed its applications.

Because Petitioner is not using either of the marks EXP or EXP COATED, and there is no evidence of commercial recognition of Petitioner's "exp" designation forming part of its model number or

product code among the relevant purchasing public, this particular *DuPont* factor weighs heavily in favor of Registrant.

DuPont Factor 2. The Similarity or Dissimilarity and Nature of Goods or Services as Described in An Application or Registration or in Connection with which the Prior Mark is Used.

First, this *DuPont* factor requires Petitioner to have “used” a “prior mark”. As submitted previously, it has been shown that Petitioner has no priority of use of the mark EXP. There is no evidence that anyone other than dealers have seen the designation “exp” in connection with any of Petitioner’s products. The designations “EEXP”, “EXP1” and “EXP2” are used on dealer price lists only. The designations “EXP1EBCT1”, “EXP2EBGH1” and “EXP2KOGH1” are used as on dealer invoices only. In each instance, these designations are used not as a trademark but rather as an alphanumeric code which is unperceivable by the reader as a trademark. They are among hundreds of alphanumeric codes used on dealer invoices, all being of the same type, font, and character. The “exp” portion of the alphanumeric code in which it is used is indistinguishable from the rest of the code, or codes.

Registrant uses the mark EXP and EXP COATED on “strings for musical instruments”. This is the identification of goods in U.S. Registration No. 2,554,110 and U.S. Registration No. 2,554,111, which are the subject of this cancellation proceeding. Petitioner admits that it never used the trademark EXP COATED. Berryman Tr. 189:17-21.

As far as the similarities and dissimilarities between Registrant’s and Petitioner’s products are concerned, musical instrument strings are simply not the same as, or similar to, guitars. Although one may be used with the other, in the same way that the Bixonic EXP-2001 effects processor (Ex. H) and the EXP guitar expression pedal manufactured by Roland Corporation (Ex. G) and the EXP/EX3 guitar equalizer sold by Kimex Trading Ltd. (Ex. I) are used with guitars, one is an accessory and the other is a musical instrument. They are different products, although admittedly usable with one another. Their costs to consumers are also quite disparate, Registrant’s EXP and EXP COATED strings being sold for

about \$9.99 to \$14.99 (D'Addario Tr. 19:25-20:5), and the Explorer guitar sold by Epiphone and by Gibson (Petitioner herein) for \$200.00 and \$1,500.00, respectively. Berryman Tr. 194:21-24. Registrant submits that confusion would lie between like products using the same or similar marks, i.e., guitar and guitar, or strings and strings, but not cross-confusion between accessories and guitars. Such a premise is supported by the record, as Petitioner, if it were really using the mark EXP since 1993 as it argues it has, concurrently with the extensive marketing of Registrant's EXP and EXP COATED strings, and Registrant alike, found no evidence of confusion to the public as to the source of the goods on which the mark EXP is used. D'Addario Tr. 39:2-15, 39:24-40:16; Ex. A (Responses 1 and 18 in Petitioner's Responses to Registrant's First Set of Interrogatories dated April 15, 2003; Item 15 in Registrant's Notice of Reliance dated March 17, 2004).

Interestingly, even with third party users of the mark EXP on guitars, e.g., EXP guitars sold by Peavey Electronics Corporation (Ex. C), EXP guitars sold by The Legend Guitar Company (Ex. D), EXP guitars sold by Ed Roman Guitars (Ex. E) and EXP guitars sold by The ESP Guitar Company (Ex. F), both Petitioner and Registrant found no evidence of consumer confusion with their products.

Accordingly, the dissimilarity in the products, and the fact that Petitioner has not shown prior use of the marks EXP and EXP COATED, tend to tip this *DuPont* factor in favor of Registrant.

Du Pont Factor No. 3. The Similarity or Dissimilarity of Established, Likely-to-Continue Trade Channels.

In addressing this *DuPont* factor, the particular trade channels in which Petitioner and Registrant use the mark EXP and EXP COATED should first be established. First, Petitioner admits that it has never used the mark EXP COATED. Berryman Tr. 188:23-189:21. Second, Petitioner's use of the term "exp" is limited to dealer price lists, Berryman Tr. 170:5-173:15, 174:17-176:10 (also, see exhibits and Berryman transcript citations at 29), as part of a longer code, and to dealer invoices, also as part of a longer code. Petitioner submits no testimony or documentary evidence that it has never used the mark

EXP on or with a product it shipped in interstate commerce before December 8, 2000, the filing dates of Registrant's trademark applications. The objected to warranty card (Ex. 14) was allegedly shipped after Registrant's priority date and actual use of its marks EXP and EXP COATED and, therefore, is irrelevant to the issues herein. Accordingly, the relevant channels of trade in which Petitioner has allegedly used the term "exp" is limited to dealers and retailers of its guitars, not the consuming public or end user of the product.

Registrant, on the hand, has distributed its EXP and EXP COATED strings not only to retailers and distributors, but also to end users and the consuming public, where Petitioner's use the mark EXP is non-existent. Accordingly, even assuming, *arguendo*, that Petitioner has established a prior, actual use of the EXP and EXP COATED marks on its dealer prices lists and dealer invoices, such use is limited to a higher level channel of trade, and only with such limited dealers and retail establishment owners. The consuming public who visit such retail establishments would never see the dealer invoices and dealer price lists and would never come to know of the existence of Petitioner's alleged mark, as it is not found on Petitioner's product they would buy or in any of Petitioner's product catalogs they may chance to see.

Registrant, on the other hand, distributes its EXP and EXP COATED products in a lower level channel of trade encompassing the end user and consuming public, where Petitioner's use of the mark EXP is not found.

Accordingly, it is urged that there are differences between the channels of trade where Registrant sells its products bearing the marks EXP and EXP COATED, and where Petitioner allegedly uses the term "exp" as part of a longer code.

DuPont No. 4. The Conditions Under Which and Buyers to Whom Sales are Made, i.e. "Impulse" vs. Careful; Sophisticated Purchasing.

The Explorer guitar sold by Petitioner is a relatively expensive guitar, costing from \$200 to about \$1,500 and up to \$5,000. At least the more expensive Gibson Explorer guitar (not the Epiphone guitar) is

not a beginner's guitar but is more for someone who is a sophisticated purchaser who is looking for the specific shape and other characteristics of the guitar. Berryman Tr. 194:21-24. Registrant's EXP and EXP COATED strings are more expensive than ordinary strings, typically double the cost, and have certain features that are attractive to sophisticated musicians. D'Addario Tr. 43:9-21 and 44:18-24. Thus, both the Petitioner's product and the strings marketed by Registrant under the EXP and EXP COATED marks are purchased by careful, knowledgeable purchasers who would be more likely to examine and research each product more carefully prior to purchasing it. A more sophisticated purchaser would investigate and inquire in order to understand the nuances of Registrant's strings and look for tonal quality and longevity which Registrant's EXP and EXP COATED strings provide. Also, because of the relatively expensiveness nature of Petitioner's product, a consumer would not impulsively purchase such a product. It should be noted, however, that Petitioner has not used the marks EXP and EXP COATED on its products and, therefore, a consumer would not be confused between Registrant's EXP and EXP COATED strings and Petitioner's "explorer" guitar.

DuPont Factor No. 5. The Fame of the Prior Mark (Sales, Advertising, Length of Use).

With respect to this particular *DuPont* factor, Registrant submits that Petitioner has failed in its burden of proving that it, and not Registrant, owns the "prior mark". Petitioner admits that it has never used the mark EXP COATED, Berryman Tr. 188:24-189:21. Petitioner has never used the mark EXP in a product catalog or advertisement and that it only used the term "exp" on its dealer invoices and dealer price lists as part of a longer code. Berryman Tr. 170:5-173:15, 174:17-176:10 (also, see exhibits and Berryman transcript citations at 29).

Second, the partial designation "exp" as used by Petitioner on its dealer price lists and dealer invoices as part of a code, has no fame or recognition in the industry. Petitioner presents no evidence that anyone associates the mark EXP with Petitioner. First, Petitioner has produced only evidence of limited use of the term "exp" and always in a code with other letters or numbers, never alone. Petitioner has

produced price lists that are distributed to the dealer only and not the ultimate consumer. Each of these price lists uses the trademark "Explorer" for consumer recognition, not by the instrument or product code using the term "exp" as part thereof. Petitioner presents no evidence that anyone recognizes this partial "exp" code as referring to any product. Also, Petitioner includes no "TM" or other notation on the dealer price lists to alert the dealer that it considers the "exp" portion of the code to be a trademark of Petitioner.

The Petitioner also relies on dealer invoices to support its position. None of these invoices reaches the ultimate consumer. Also, none of these invoices uses the mark EXP or EXP COATED by itself. They all use such codes as "EXP1EBCT1", "EXPZEBGH1" or "EXP2K0GHI", among hundreds of other alphanumeric codes, as described previously. Petitioner has introduced no evidence that anyone recognizes the "exp" part of these codes to be a trademark of Petitioner or associates the "exp" portion of the code with Petitioner's product. Furthermore, Petitioner makes no attempt to enlighten the dealer who receives the invoice that the "exp" portion of the code is a trademark of Petitioner.

None of the Explorer guitars or any other product sold by Petitioner bears the mark EXP. The only other item relied on by Petitioner is a late produced warranty card which is allegedly received by the consumer after he purchases the Petitioner's product. This warranty card was only first used after Registrant's application for the trademark EXP and EXP COATED was filed and, therefore, does not establish priority of use by Petitioner. Petitioner has also not produced any advertising or promotional expenditures to support a claim of establishing consumer recognition; and consequent "fame". Registrant, on the other hand, has EXP and EXP COATED string sales of over \$1,000,000 for the most recent year (2003) and more than \$300,000 in advertising and promotion of its EXP and EXP COATED marks for the year 2003. It is Registrant, not Petitioner, who has established both prior use and "fame" of its marks EXP and EXP COATED, and evidence of such use, promotion, advertising and public recognition of its marks has not been refuted by Petitioner. Accordingly, it is respectfully urged that this particular *Du Pont* factor favors Registrant.

Dupont Factor No. 6. The Number and Nature of Similar Marks in Use on Similar Goods.

Beside Petitioner, there are several other companies that sell guitars using the mark EXP. These companies include Peavey Electronics Corporation, which sells several models of EXP guitars. Ex. C; D'Addario Tr. 62:7-16; Berryman Tr. 32:20-36:7. Other companies include The Legend Guitar Company, which sells EXP guitars, and Ed Roman Guitars, which markets EXP guitars. Ex. D; Berryman Tr. 41:23-42:17, 45:19-46:2; Ex. E; Berryman Tr. 46:5-47:2, 47:22-48:1. Another company offering EXP guitars is The ESP Guitar Company. Ex. F; Berryman Tr. 54:15-55:14, 56:21-57:7. Unlike Petitioner, these companies have been referring to their guitars by the mark EXP in advertisements. Petitioner has never advertised its products using the EXP mark.

Beside the many EXP guitars of third parties on the market today, there are also guitar accessories sold in the same types of retail establishments as Petitioner's guitars that use the mark EXP. Berryman Tr. 57:14-61:12. Third parties selling guitar accessories under the mark EXP at stores that also sell Petitioner's guitars include Roland Corporation, which sells an EXP guitar expression pedal. Ex. G; Berryman Tr. 61:13-63:16. Other guitar accessories that are similarly sold and use the mark EXP include the EXP-2001 guitar effects processor sold by Godlyke Distributing Inc. (Bixonic). Ex. H; Berryman Tr. 63:25-65:5. Equalizers used by guitarists to modify the sound of their guitars are sold under the mark EXP/EX3, by Kimex Trading Ltd. Ex. I; Berryman Tr. 67:19-69:8.

Petitioner claims that after Registrant informed it of these uses of the mark EXP on guitars and related musical accessories, it wrote a letter to certain of the guitar manufacturers (not the musical accessory manufacturers). However, none of these letters was ever produced, and Petitioner's sole witness, the President of the company, never saw them and could not testify as to their content, to whom they were addressed and other particulars about warning these third party guitar distributors about Petitioner's alleged rights in the mark. Berryman Tr. 36:8-10; 47:3-7; Ex. E; Ex. C; Berryman Reb. Tr. 10:15-12:24. It is telling here, apparently, that Petitioner finds no likelihood of confusion with

distributors of guitar accessories who use the mark EXP in connection with their sale of accessories to warrant a warning letter. Petitioner, without submitting proof, claims that it sent warning letters only to guitar distributors who are using the EXP mark. No warning letters were written to distributors of musical instrument accessories, such as Registrant, who are using the mark EXP on their products. Berryman Tr. 8:16-25, 12:3-24, 12:25-14:22, 27:10-28:12.

Petitioner also claims that it actively polices the market for uses of its marks. Apparently, Petitioner never considered EXP to be its proprietary mark, as it was unaware of third party guitar distributors who use the mark EXP until Registrant brought such users to Petitioner's attention. Also, it is believed that, if Petitioner actually wrote warning letters to third party guitar distributors, it did so not because the guitar distributors were using the mark EXP, but rather because they copied the trade dress (shape) of Petitioner's "explorer" guitar. Ex. E; Berryman Tr. 47:3-48:13. Since no such letters were ever produced, and since the President of Petitioner, Mr. Berryman, Petitioner's only witness, could not testify as to the content of such letters, Berryman Tr. 10:15-12:24; Ex. C, Berryman Reb. Tr. 36:8-10, there is no evidence supporting Petitioner's contention that it polices the market for third party users of the EXP mark.

Even with all of the many third party users of the mark EXP who distribute either guitars or accessories for guitars, and even with Registrant's major advertising, promotion and sales of musical instrument strings using the marks EXP and EXP COATED, Petitioner and Registrant have not seen one instance of actual confusion in the marketplace with respect to the use of these marks and the source of the goods in connection with which the marks are used. D'Addario Tr. 39:2-15, 39:24-40:16; Ex. A (Responses 1 and 18 in Petitioner's Responses to Registrant's First Set of Interrogatories dated April 15, 2003; Item 15 in Registrant's Notice of Reliance dated March 17, 2004).

Dupont Factor No. 7. The Nature and Extent of Any Actual Confusion.

Petitioner and Registrant have found no instances of any actual confusion between their respective use of the marks EXP and EXP COATED. D'Addario Tr. 39:2-15, 39:24-40:16; Ex. A (Responses 1 and 18 in Petitioner's Responses to Registrant's First Set of Interrogatories dated April 15, 2003; Item 15 in Registrant's Notice of Reliance dated March 17, 2004). Furthermore, even with all of the many third party users of the mark EXP who distribute either guitar or accessories for guitars, both Petitioner and Registrant have not seen any actual confusion in the marketplace with respect to the use of these marks and the source of the goods in connection with which the marks are used.

Certainly, the Petitioner has seen no actual confusion, as it does not advertise and promote the mark EXP, Ex. A (Responses 1 and 18 in Petitioner's Responses to Registrant's First Set of Interrogatories dated April 15, 2003; Item 15 in Registrant's Notice of Reliance dated March 17, 2004). Nor has Petitioner produced any evidence showing that it used the mark on any labels or packaging for the product, or on the product itself, when the product is shipped in interstate commerce. The warranty card allegedly now used by Petitioner does not impart to the consumer any recognition or knowledge that the term "exp" is considered a trademark of Petitioner, and Petitioner submits no evidence on the extent of such distribution of the warranty cards. This lack of use by Petitioner of the mark EXP most likely explains why there is no actual confusion between the parties.

Even assuming, *arguendo*, that Petitioner has been using the "exp" notation since 1993, as it alleges in its trial brief, at 8, there has been at least a concurrent use of the mark EXP by Petitioner and Registrant for at least three and a half years. During this time, no actual confusion has been found by either party. As stated by the Federal Circuit in *Cortex Corporation v. W.L. Gore & Associates, Inc.*, 1 F.3d 1253, 28 U.S.P.Q.2d 1152, concerning the lack of evidence of actual confusion:

"The absence of actual confusion underscores that the dissimilarity of marks, products, and trade channels greatly reduces or negates any

possibility of confusion. Although proof of actual confusion is not necessary to show likelihood of confusion, e.g., *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 1571, 218 USPQ, 390, 396 (Fed.Cir.1983), its absence in this case strongly reinforces the conclusion compelled by the other relevant Du Pont factors.”

1 F.3d at 1253; 28 U.S.P.Q. 2d at 1154.

It should be further noted that the trademarks EXP and EXP COATED are recognized by the consumer as being associated with the Registrant as the source of the strings on which the marks EXP and EXP COATED are used. Registrant has placed into evidence unsolicited letters from customers who have purchased its EXP and EXP COATED strings and refer to the product by the mark. Ex. BU; D'Addario Tr. 12:10-13:7. Petitioner, on the other hand, has introduced not a single document from a third party showing recognition of the mark EXP as a trademark of Petitioner, or showing an association of the mark EXP with Petitioner or its products. As mentioned previously, Registrant also prominently displays its trademarks EXP and EXP COATED on the packaging of its strings. Ex. CD; D'Addario Tr. 27:19-24. Petitioner, on the other hand, has never used the mark EXP COATED, Berryman Tr. 188:24-189:21, and has never used the mark EXP on its products or in its catalogs. Accordingly, it is urged that this particular *DuPont* factor weighs in favor of Registrant.

DuPont Factor No. 8. The Length of Time During and Conditions Under Which There Has Been Concurrent Use Without Evidence of Actual Confusion.

As described above in response to the previous *DuPont* factor, Petitioner has allegedly used the EXP mark since 1993, and Registrant has extensively advertised and promoted the marks EXP and EXP COATED in its catalogs, flyers, advertisements and on its products since April, 2001. Accordingly, there is a substantial concurrent use, at least allegedly, of the mark by both Petitioner and Registrant without a scintilla of evidence of any actual confusion existing in the marketplace.

There are significant reasons why there is no confusion. First, the customers of both Petitioner and Registrant are highly sophisticated. Petitioner's "explorer" guitar is a relatively high priced guitar (\$200 to \$5,000) and not an instrument necessarily purchased by beginning musicians who are not

knowledgeable about the product. Registrant's strings are higher priced sets of strings that are also not typically sought after by the novice musician. D'Addario Tr. 43:9-21.

A second reason why there has been no actual confusion arises from the non-use of the marks EXP and EXP COATED by Petitioner. Petitioner does not advertise and promote the marks EXP and EXP COATED. It has spent no money on advertising and promoting EXP over all the years (since 1993) it claims to have used it.

Thirdly, Petitioner has not used the marks EXP or EXP COATED by itself. The term "exp" is only found as part of a larger alphanumeric code in Petitioner's dealer invoices and dealer price lists. Berryman Tr. 170:5-173:15, 174:17-176:10 (also, see exhibits and Berryman transcript citations at 29).

Fourth, no one recognizes the marks EXP and EXP COATED as being associated with Petitioner. Petitioner's use of the designation "exp" is so minimal that no one has basically heard of it. There was no third party recognition of the designation introduced into evidence by Petitioner.

Fifth, Petitioner admits that it has never used the mark EXP COATED. Berryman Tr. 188:24-189:21.

DuPont Factor No. 9. The Variety of Goods on Which a Mark is or is Not Used (House Mark, "Family Mark, Product Mark").

First, it is clear from the record that the mark EXP has never been used on Petitioner's products. The notation "exp" is only used as part of a code on Petitioner's dealer price lists and dealer invoices. Ex. AG, Q; Berryman Tr. 170:5-173:15, 174:17-176:10 (also, see exhibits and Berryman transcript citations at 29). The mark EXP has never been used in any product catalogs or advertising of Petitioner. Furthermore, Petitioner admits that it has never used the mark EXP COATED. Berryman Tr. 188:24-189:21.

On the other hand, Registrant has extensively used the EXP and EXP COATED marks directly on its products and in advertisements and other promotional material for many years. D'Addario Tr. 26:13-28:3.

Second, Registrant used the marks EXP and EXP COATED only on accessories for musical instruments, and in particular, strings for various types of instruments. D'Addario Tr. 27:6-18. Petitioner, on the other hand, does not use the marks EXP and EXP COATED on its products, but alleges that it uses the term "exp" as part of a code on its dealer price lists and dealer invoices relating solely to guitars. Accordingly, the variety of goods in connection with which each party uses or allegedly uses the EXP and EXP COATED marks is limited to guitars (allegedly for Petitioner) and musical instrument strings (for Registrant). Thus, a likelihood of confusion between Petitioner's hypothetical use of the marks EXP and EXP COATED and Registrant's use of the marks is limited to those precise products mentioned above and, as Registrant asserts, non-existent.

Third, the partial "exp" designation asserted by Petitioner is one of hundreds of different designations used by Petitioner in its instrument and product codes on its dealer price lists. These product and instrument codes include the following as but a few examples: "GIG"; "GEG"; "PPGR"; "PPGR"; "PPGR"; "PPGR"; "EA10"; "ELPP"; "EFVP"; "EANT"; "EAI1"; "ESP11"; and "ESPSG".

Petitioner's Exhibit 11 is representative of all of Petitioner's dealer price lists and lists 130 instrument codes alone, including "EXP2" listed twice out of the 130 different codes. There has been no evidence presented by Petitioner that the codes "EXP2" or "EXP1" have ever been singled out in any fashion by Petitioner, or denoted by a "TM" notation or advisory note, to distinguish the "exp" portion thereof as a trademark of Petitioner from all the other 128 instrument codes listed thereon. Ex. 11. In effect, the codes having an "exp" in them are indistinguishable, as far as Petitioner claiming trademark rights, therein from any of the other codes found on the dealer price lists.

In addition to the 130 or more instrument codes, the price lists include a plurality of color codes as well. These color codes include: "EB"; "VS"; "RE"; "NA"; "BS"; "JB"; "CH"; "VS"; "AN"; "BK"; "BM"; "BR"; "MR"; and "TQ". Ex. 11.

Taking Petitioner's arguments to their logical conclusion, there are only a handful of letter combinations remaining available to the public that do not belong to Petitioner. As with the case of the instrument codes, none of these color codes has ever been brought to the attention of the public in any advertising or promotional material.

Thus, there is no family of marks used by Petitioner that Petitioner can rely on to demonstrate that the marks EXP and EXP COATED belong exclusively to Petitioner. Accordingly, Registrant respectfully urges that this *DuPont* factor weighs in favor of Registrant.

DuPont Factor No. 10. The Market Interface Between Applicant and the Owner of the Prior Mark.

First, with respect to this particular *DuPont* factor, Petitioner is not the "owner of the prior mark". Petitioner has admittedly not used the mark EXP COATED, Berryman Tr. 188:24-189:21. Petitioner has not used the mark EXP on any of its products, and has never advertised or promoted, nor spent any amount on advertising or promotion of, the mark EXP. Petitioner has only used the notation "exp" as part of an instrument or product code on its dealer invoices and dealer price lists. Ex. AO, AT, AU, AX, AY, BA, BB, BD-BQ; Berryman Tr. 170:5-173:15, 174:17-176:10. Accordingly, Petitioner has no market interface with the consuming public or end user of its product with respect to the mark EXP and the mark EXP COATED, and has only a limited market interface with its dealers with respect to the dealer invoices and dealer price lists which use the notation "exp" as part of a code.

Both Petitioner and Registrant are well known in their respective markets, but for different reasons. Petitioner is allegedly well known for the quality of its guitars and allegedly for the shape of its guitars, not for its use of the marks EXP and EXP COATED. Registrant is well known for the quality and longevity of its strings, which are distinguished from other string manufacturers by its well known

and highly promoted EXP and EXP COATED marks. Ex. BU; D'Addario Tr. 11:18-13:7. There is no evidence that anyone associates the marks EXP and EXP COATED with Petitioner. However, there is significant evidence that the marks EXP and EXP COATED are associated with Registrant and its strings. There have been industry awards bestowed on Registrant for the quality of its EXP and EXP COATED strings. Ex. CD. Famous musicians attest to the quality of the strings sold under the marks EXP and EXP COATED. Ex. BY; D'Addario Tr. 34:8-19. Consumers have written unsolicited appreciation letters to Registrant praising the quality of its EXP and EXP COATED strings. Ex. BU; D'Addario Tr. 12:10-13:7. Registrant has over \$1,200,000 in sales over the last calendar year (2003) of its EXP and EXP COATED strings which bear Registrant's marks, D'Addario Tr. 29:15-30:24; Ex. BX, and has spent over \$330,000 dollars in advertising and promoting the EXP and EXP COATED marks in just 2003 alone. Ex. BZ; D'Addario Tr. 37:4-38:4.

Accordingly, Registrant has a highly developed market with the end user and consuming public for its EXP and EXP COATED strings. At this comparable market level, Petitioner's use and promotion of the EXP mark and the EXP COATED mark are non-existent.

Further demonstrating that there is no market overlap between Petitioner and Registrant, neither party has found any evidence of actual confusion during its concurrent use (that is, an alleged use by Petitioner) of the EXP and EXP COATED marks. Ex. BU; D'Addario Tr. 39:2-15.

DuPont Factor No. 11. The Extent to Which Applicant Has a Right to Exclude Others from the Use of Its Mark On Its Goods.

Petitioner has made no attempt to police its "exp" notation until put on notice by Registrant of third party users. At no time did Petitioner produce a single document generated by Petitioner or its counsel to any third party, challenging the use by a third party of the mark EXP. Petitioner's President Mr. Berryman's testimony is barren of the content of any letters sent to third parties, and the basis for such letters. Mr. Berryman had no knowledge of even the generalities, let alone the specifics, about the

generation of such letters sent to third party distributors of guitars. Berryman Reb. Tr. 10:15-12:24; Ex. C; Berryman Tr. 36:8-10. Mr. Berryman testified that he routinely checks for third party infringers of Petitioner's trademarks, Berryman Tr. 43:16-44:7, but yet a simple Internet search by Registrant revealed a number of manufacturers and distributors of guitars and musical accessories for use with guitars that sell their products using the mark EXP of which Mr. Berryman was unaware. Berryman Reb. Tr. 14:12-19. At his deposition, Mr. Berryman thanked Registrant for calling such information to his attention. Ex. E; Berryman Tr. 46:5-48:13. Obviously, Petitioner paid no import to these third party users of the mark EXP, as it never considered such a mark to be proprietary to Petitioner. Even the extensive advertising and promotion and sales of Registrant's strings under the marks EXP and EXP COATED failed to gain the attention of Petitioner until Registrant's registrations caused difficulty with Petitioner's late-filed intent-to-use trademark applications for the marks EX and EXP. Any letters sent by Petitioner to third party guitar manufacturers or distributors were never introduced into evidence, and Mr. Berryman's generalized testimony regarding such letters is hearsay and inadmissible. Fed. R. Evid. 602. It is further of interest to note that Petitioner never alleges that it sent warning letters to manufacturers and distributors of musical instrument accessories, such as the Registrant and others previously mentioned, and who were also brought to the attention of Petitioner after Registrant conducted a simple Internet search for such third party users on the mark EXP. It may be concluded from the record that Petitioner's claim to police the market is a hollow assertion.

DuPont Factor No. 12. The Extent of Potential Confusion, i.e. Whether de minimis or Substantial.

Registrant submits that any potential confusion between Petitioner's use of the mark EXP and Registrant's use of the mark EXP and EXP COATED is *de minimis*. Petitioner has not shown any inclination to expand its limited use of the term "exp" from part of its codes on its dealer invoices and dealer price lists. It has not advertised or promoted the mark EXP. Petitioner has submitted no evidence of any monetary expenditures since its alleged use of the part-code "exp" since 1993 to the present. Petitioner has not, and probably never will, use the mark EXP COATED. Berryman Tr. 188:23-189:2.

Since Petitioner has started its alleged use of “exp”, and throughout the period of concurrent use of the mark EXP and the mark EXP COATED by Registrant and the term “exp” by Petitioner on its dealer price lists and dealer invoices, there has never been any instance of confusion by the public or anyone concerning the use of the mark EXP and the source of the goods produced under the mark. D’Addario Tr. 39:2-15, 39:24-40:16; Ex. A (Responses 1 and 18 in Petitioner’s Responses to Registrant’s First Set of Interrogatories dated April 15, 2003; Item 15 in Registrant’s Notice of Reliance dated March 17, 2004). This is even in view of the extensive marketing of Registrant’s strings under the EXP and EXP COATED marks, and the extensive advertising and promotion of Registrant’s EXP and EXP COATED marks.

Also, there is no evidence of confusion in the marketplace, even taking into account the third party users of the mark EXP on guitars and guitar accessories. Accordingly, Registrant respectfully submits that any potential for confusion between Registrant’s and Petitioner’s use of the mark EXP is *de minimis*.

DuPont Factor No. 13. Any Other Established Fact Probative of the Effect of Use.

One important factor that should not be overlooked is the good faith of Registrant. The testimony of Registrant is clear that it was not aware of any use of the term “exp” by Petitioner forming part of its codes in its dealer invoices and dealer price lists prior to Registrant selecting the EXP and EXP COATED marks, as Registrant, like anyone else, would not be privy to such information. The fact that a string company in the music industry was not aware of the use of the part-code “exp” by Petitioner, a guitar company, in view of Petitioner’s claim of its long use of the mark EXP, demonstrates that the scope and extent of Petitioner’s use of the “exp” code is *de minimis*.

CONCLUSION

Petitioner appears to be a latecomer in trying to obtain registrations for its “exp” and “ex” notations. It filed intent-to-use applications, as it had no actual use of the marks that it could rely on.

When it learned that Registrant's registrations were blocking its attempt to register its marks, it concocted a rather contrived priority-of-use basis for suspending prosecution of its applications and for attempting to cancel Registrant's marks. No confusion or likelihood of confusion is evident, as Petitioner never really used the mark EXP and the mark EXP COATED (it particular admits to the non-use of the mark EXP COATED). Even with all of the extensive marketing, promotion and advertising of Registrant's marks EXP and EXP COATED and major sales of Registrant's products bearing the marks EXP and EXP COATED, Petitioner had no concerns about this in the marketplace. It was only when its late-filed applications were blocked that it sought cancellation of Registrant's registrations.

The evidence submitted by Petitioner is totally lacking of any credible showing of actual use or analogous use of the marks EXP and EXP COATED, and Petitioner failed in its burden of proof in showing that it has priority of use of these marks, over Registrant. It has shown no advertisement and promotion of these marks, and submitted no evidence of monetary expenditure for advertising or promotion. It has further not shown any recognition by the public of the trademark significance of the term "exp" that it uses as part of its codes in its dealer price lists and dealer invoices. No confusion was found by Petitioner, as the consuming public and anyone else would never consider Petitioner's use of its "exp" notation to be a trademark of Petitioner. Petitioner submitted no surveying evidence to show recognition by anyone of its right to the EXP and EXP COATED marks or an association of these marks with Petitioner and Petitioner's products. Accordingly, Petitioner failed in its burden of proof and, therefore, its petition for cancellation of Registrant's registrations of the marks EXP and EXP COATED should be denied.

EVIDENTIARY OBJECTIONS

Registrant objects to the admission of the following evidence being offered by the Petitioner:

1. Registrant objects to the admission of the testimony on page 8, lines 16-22 of the deposition of David H. Berryman on January 7, 2004 on the ground it is hearsay under Rule 802 of the

Federal Rules of Evidence.

2. Registrant objects to the admission of the testimony on page 11, line 23 to page 12, line 3 of the deposition of David H. Berryman on January 7, 2004 on the ground that the witness lacks personal knowledge as required under Rule 602 of the Federal Rules of Evidence.

3. Registrant objects to the admission of Exhibit 14 and the testimony relating thereto on page 30, lines 7-12 of the deposition of David H. Berryman on January 7, 2004 on the ground that the Exhibit was never produced during discovery despite being requested and the Petitioner never supplemented its discovery responses to produce the Exhibit as required under Rule 26 of the Federal Rules of Civil Procedure.

4. Registrant objects to the admission of the testimony on page 94, lines 9-23 of the deposition of David H. Berryman on January 7, 2004 on the ground that the witness lacks personal knowledge as required under Rule 602 of the Federal Rules of Evidence.

5. Registrant objects to the admission of the testimony on page 94, line 24 to page 97, line 10 of the deposition of David H. Berryman on January 7, 2004 on the ground that the witness lacks personal knowledge as required under Rule 602 of the Federal Rules of Evidence.

6. Registrant objects to the admission of the testimony on page 98, line 9 to page 99, line 21 of the deposition of David H. Berryman on January 7, 2004 on the ground that the witness lacks personal knowledge as required under Rule 602 of the Federal Rules of Evidence.

7. Registrant objects to the admission of the testimony on page 199, lines 14-16 of the deposition of David H. Berryman on January 7, 2004 on the ground it is hearsay under Rule 802 of the Federal Rules of Evidence.

8. Registrant objects to the admission of the testimony on page 199, lines 19 to 200, line 8

of the deposition of David H. Berryman on January 7, 2004 on the ground it is hearsay under Rule 802 of the Federal Rules of Evidence.

9. Registrant objects to the admission of the cross examination testimony on page 69, line 11 to page 71, line 9 of the deposition of James D'Addario on March 4, 2004 on the ground it is outside the scope of direct testimony.

10. Registrant objects to the admission of the cross examination testimony on page 87, line 16-22 of the deposition of James D'Addario on March 4, 2004 on the ground it is outside the scope of direct testimony.

11. Registrant objects to the admission of the cross examination testimony on page 88, line 9-15 of the deposition of James D'Addario on March 4, 2004 on the ground it is outside the scope of direct testimony.

12. Registrant objects to the admission of the testimony on page 4, line 15 to page 8, line 12 of the deposition of David H. Berryman on April 16, 2004 on the ground that it is not proper rebuttal testimony.

13. Registrant objects to the admission of Exhibit 17 and the testimony relating thereto on page 4, line 15 to page 8, line 12 of the deposition of David H. Berryman on April 16, 2004 on the ground that the document and testimony is hearsay under Rule 802 of the Federal Rules of Evidence.

14. Registrant objects to the admission of the testimony on page 4, line 15 to page 8, line 12 of the deposition of David H. Berryman on April 16, 2004 on the ground that the testimony relates to documents that were never produced to Registrant during discovery or prior to the testimony.

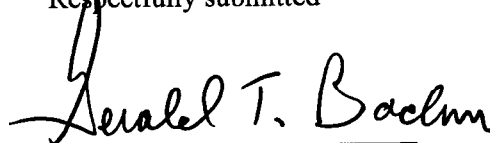
15. Registrant objects to the admission of the testimony on page 4, line 15 to page 8, line 12 of the deposition of David H. Berryman on April 16, 2004 on the ground that the witness lacks personal

knowledge as required under Rule 602 of the Federal Rules of Evidence. The lack of personal knowledge is shown in his cross examination at page 8 line 14 to page 15, line 4.

16. Registrant objects to the admission of Exhibit 17 on the ground of lack of foundation as to authenticity under Rule 901 of the Federal Rules of Evidence.

17. Registrant objects to the admission of Exhibit 17 and the testimony relating thereto on page 4, line 15 to page 8, line 12 of the deposition of David H. Berryman on April 16, 2004 on the ground of relevance under Rule 402 of the Federal Rules of Evidence.

Respectfully submitted

A handwritten signature in cursive script that reads "Gerald T. Bodner". The signature is written in dark ink and is positioned above the printed name and address.

Gerald T. Bodner
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Attorneys for Registrant
J. D'Addario & Co., Inc.

CERTIFICATE OF SERVICE

MARK: EXP and EXP COATED

REGISTRATION NO.: 2,554,110 and 2,554,111

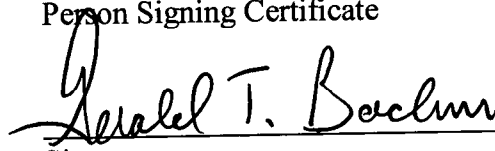
CANCELLATION NO.: 92041175 and 92041688 (Consolidated)

**NAME OF PARTY
SERVING PAPERS:** Gerald T. Bodner on behalf of Registrant,
J. D'Addario & Co., Inc.

TYPE OF PAPERS: REGISTRANT'S BRIEF IN OPPOSITION TO THE
PETITION FOR CANCELLATION

I, Gerald T. Bodner, an attorney, hereby certify that the above-identified document is being forwarded to: Edward D. Lanquist, Jr., Esq., WADDEY & PATTERSON, 414 Union Street, Suite 2020, Nations Bank Plaza, Nashville, Tennessee 37219 on August 2, 2004, via first class mail.

Gerald T. Bodner
Person Signing Certificate


Signature

August 2, 2004
Date of Signature

CERTIFICATE OF EXPRESS MAIL

MARK: EXP and EXP COATED

REGISTRATION NO.: 2,554,110 and 2,554,111

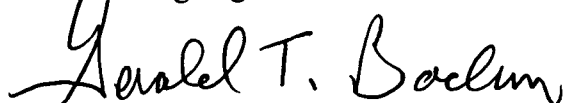
CANCELLATION NO.: 92041175 and 92041688 (Consolidated)

**NAME OF PARTY
SERVING PAPERS:** Gerald T. Bodner on behalf of Registrant,
J. D'Addario & Co., Inc.

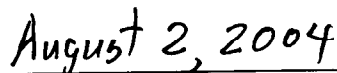
TYPE OF PAPERS: REGISTRANT'S BRIEF IN OPPOSITION TO THE
PETITION FOR CANCELLATION

I, Gerald T. Bodner, an attorney, hereby certify that an original and two copies of the above-identified document is being forwarded to: United States Patent and Trademark Office, Trademark Trial and Appeal Board, 2900 Crystal Drive, Arlington, Virginia 22202-3513 on August 2, 2004, via Express Mail, Post Office to Addressee, Express Mail No. ER791081306US.

Gerald T. Bodner
Person Signing Certificate



Signature



Date of Signature